



February 2014

# Dancing Promotions, Dodging Preemption, and Defending Personas: Why Preempting the Right of Publicity Deprives Talent the Publicity Protection They Deserve

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## Recommended Citation

Sean Elliott, *Dancing Promotions, Dodging Preemption, and Defending Personas: Why Preempting the Right of Publicity Deprives Talent the Publicity Protection They Deserve*, 73 Notre Dame L. Rev. 1625 (1998).

Available at: <http://scholarship.law.nd.edu/ndlr/vol73/iss5/34>

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## NOTE

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# DANCING PROMOTIONS, DODGING PREEMPTION, AND DEFENDING PERSONAS: WHY PREEMPTING THE RIGHT OF PUBLICITY DEPRIVES TALENT THE PUBLICITY PROTECTION THEY DESERVE

*Actors sacrifice a lot of privacy when they become the focus of the public eye. For this and other reasons, they deserve to keep their private lives distinct from their public image, and they should be handsomely compensated for any use of their identity.*

—Sam Gores<sup>1</sup>

## I. INTRODUCTION

Artists of all trades and talents are driven by the desire, even passion, for self expression. Whether they express for fame or critical acclaim, the result is the same: very few artists attain recognizable identities or marketable personas. Those few who do achieve celebrity status find that it brings both burdens and benefits. One sizable burden is the trying loss of privacy and tiresome need to constantly appease the public imagination. On the other hand, a major benefit exists in the lucrative pecuniary value that may attach to a celebrity's persona.<sup>2</sup> In most instances, a person's public personality becomes valuable only after the investment of time, effort, skill, and perhaps

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1 Interview with Sam Gores, President of Paradigm Talent and Literary Agency, Century City, California (Nov. 21, 1997).

2 See, e.g., Melville B. Nimmer, *The Right of Publicity*, 19 LAW & CONTEMP. PROBS. 203, 215 (1954); see also *Ali v. Playgirl, Inc.*, 447 F. Supp. 723, 729 (S.D.N.Y. 1978) (taking judicial notice of the widespread commercial exploitation of names, faces, and reputations of celebrities).

money,<sup>3</sup> so the law strives to protect proprietary claims individuals have in such economically beneficial publicity interests.

Publicity rights are the state causes of action that protect the name, voice, likeness, and identity of individuals from defendants using their identities for a commercial or economic advantage.<sup>4</sup> Plaintiffs are generally public figures whose identities have a commercially exploitable value,<sup>5</sup> but publicity rights protect artists across the board, from currently unknown actors like Stephen Fleet,<sup>6</sup> to the fleet-footed dance legend, Fred Astaire.<sup>7</sup> Some courts threaten to deprive individuals of this identity protection by ruling that federal copyright law preempts publicity rights granted by the states. This Note addresses the separate and distinct protections granted both by state right of publicity laws and federal copyright law.

The *American Law Institute's Restatement (Third) of Unfair Competition*<sup>8</sup> expressly protects the commercial value of a person's identity<sup>9</sup> by incorporating the right of publicity as an independent component of unfair competition law,<sup>10</sup> and a majority of states recognize the right of publicity by means of statute, judicial decision, or both.<sup>11</sup> At

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3 See Nimmer, *supra* note 2, at 215-16. For discussion of instances in which an individual's identity becomes recognizable by accident, luck, or association with a negative event, see *infra* note 42.

4 See *Eastwood v. Superior Court*, 198 Cal. Rptr. 342, 350 (Ct. App. 1983) ("Often considerable money, time, and energy are needed to develop the ability in a person's name or likeness to attract attention and evoke a desired response in a particular consumer market.").

5 See *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 835 (6th Cir. 1983) (stating that only the identity of public figures and celebrities have a commercially exploitable value); see also Gretchen A. Pemberton, *The Parodist's Claim to Fame: A Parody Exception to the Right of Publicity*, 27 U.C. DAVIS L. REV. 97, 120 (1993) ("Although celebrities may not mean exactly the same thing to everyone, they do have meaning. Celebrities' power to 'sell' commodities with which they are associated proves that their images mean something to consumers.").

6 A recent decision of a California State Court of Appeals held that federal copyright law preempted California from extending right of publicity protection to child-actor Stephen Fleet for distribution of a film in which Fleet appeared. *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Ct. App. 1996).

7 See *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

8 RESTATEMENT (THIRD) OF UNFAIR COMPETITION §§ 46-49 (1995).

9 *Id.* § 46 cmt. a ("One who appropriates the commercial value of a person's identity by using without consent the person's name, likeness, or other indicia of identity for purposes of trade is subject to liability for the relief appropriate under the rules stated in secs. 48 and 49.").

10 *Id.* §§ 46-49.

11 See FLA. STAT. ANN. § 540.08 (West 1997); KY. REV. STAT. ANN. § 391.170 (Banks-Baldwin 1994); MASS. ANN. LAWS ch. 214, § 3A (Law. Co-op 1986); NEB. REV. STAT. ANN. § 20-202, -208 (Michie 1991); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney

the federal level, copyright law protects the ingenuity, invention, and investment of a creator's energies. Current federal copyright law, the product of the Copyright Act of 1976, protects original works of authorship that a creator expresses in a tangible form. It expressly states that federal law provides the lone rule on copyright issues and preempts any state law that attempts to offer rights granted by the 1976 Copyright Act.<sup>12</sup> Thus, if a right of publicity law of a state offers rights granted by the 1976 Copyright Act, the federal law will preempt the state-created cause of action.

A majority of courts, commentators, and legal scholars agree that the 1976 Copyright Act does not preempt a state's right of publicity law.<sup>13</sup> For instance, the Ninth Circuit has held that California's right of publicity is not preempted by federal law.<sup>14</sup> On the other hand, a decade-old decision by the Seventh Circuit<sup>15</sup> held that federal copyright law preempted a state's right of publicity law. This case threw

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1992); OKLA. STAT. ANN. tit. 21, § 839.1 to .3 (West 1983); R.I. GEN. LAWS § 9-1-28 (1997); TENN. CODE ANN. § 47-25-1101 to -1108 (1995); UTAH CODE ANN. § 45-3-1 to -6 (1993); VA. CODE ANN. § 8.01-40 (Michie 1992); WIS. STAT. ANN. § 895.50 (West 1997); see also *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 566 (1977); *Carson v. Here's Johnny Portable Toilets, Inc.*, 698 F.2d 831, 834 (6th Cir. 1983); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978); *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8th Cir. 1969); *Philadelphia Orchestra Ass'n v. Walt Disney Co.*, 821 F. Supp. 341, 349 (E.D. Pa. 1993); *Allen v. National Video, Inc.*, 610 F. Supp. 612, 621 (S.D.N.Y. 1985) (stating that New York no longer recognizes a distinct publicity right and only affords protection under its privacy statute); *Estate of Elvis Presley v. Russen*, 513 F. Supp. 1339, 1354 (D.N.J. 1981); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1281 (D. Minn. 1970); *Lugosi v. Universal Pictures*, 603 P.2d 425, 428 (Cal. 1979); *Martin Luther King, Jr., Cir. for Soc. Change, Inc. v. American Heritage Prods. Inc.*, 296 S.E.2d 697, 702 (Ga. 1982); *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 584 (N.Y. 1984); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979).

12 17 U.S.C. § 301 (1994).

13 See *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977); *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1098-1100 (9th Cir. 1992); *Midler v. Ford Motor Co.*, 849 F.2d 460, 462-63 (9th Cir. 1988); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978); *Bi-Rite Enters. v. Button Master*, 555 F. Supp. 1188, 1201 (S.D.N.Y. 1983); *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979); *Nimmer*, *supra* note 2, at 215-16. But see *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675 (7th Cir. 1986); *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Ct. App. 1996); *David E. Shipley*, *Publicity Never Dies; It Just Fades Away: The Right of Publicity and Federal Preemption*, 66 CORNELL L. REV. 673 (1981).

14 See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093 (9th Cir. 1992); see also *Midler v. Ford Motor Co.*, 849 F.2d 460 (9th Cir. 1988).

15 *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).

commentators into a frenzy<sup>16</sup> and left legal observers wondering how it would affect other circuits' treatment of the issue; but such rulings were not confined to courts within the Seventh Circuit. Last year a California State Court of Appeals ruled consistently with the Seventh Circuit decision and held that federal copyright law preempted California's right of publicity.<sup>17</sup>

Although artists deserve the protection of the law no matter where they ply their trade, publicity rights attach only to those with a publicly recognizable identity. Therefore, it is paramount that California, the queen of cinema and capital of the entertainment enterprise, actively and consistently recognizes and protects the rights artists have in their identities.<sup>18</sup> Since the Ninth Circuit often serves as the "Hollywood Circuit,"<sup>19</sup> issues raised in a case recently decided by that court<sup>20</sup> provide a suitable backdrop for discussing whether federal law preempts state rights of publicity.

In this Note, I focus on the conditions required for federal copyright law to preempt state law. Part II familiarizes the reader with the facts of *Astaire v. Best Film & Video*,<sup>21</sup> which was recently decided by the Ninth Circuit on grounds distinct from the preemption issue but whose parties raised insightful preemption arguments nonetheless. Part III outlines the policy considerations and evolution of the right of publicity cause of action and, in light of *Astaire*, I focus on California's right of publicity law.

In Part IV, I attempt to familiarize the reader with federal copyright law, and I focus on the preemption of state law. I also discuss the impact of several preemption cases from around the country, including the recent California Court of Appeals ruling in favor of preemption in *Fleet v. CBS, Inc.*<sup>22</sup> Part V contrasts federal copyright

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16 See, e.g., Nimmer, *supra* note 2, at 215-16; Shelley Ross Saxer, Note, Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n: *The Right of Publicity in Game Performances and Federal Copyright Preemption*, 36 UCLA L. REV. 861 (1989).

17 *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645 (Ct. App. 1996) (holding that federal copyright law preempts California's right of publicity). *Fleet* has received harsh criticism from leading entertainment attorneys. Telephone Interview with Vincent Chieffo, Partner, Gipson, Hoffman, & Pancione, Century City, Cal. (Apr. 14, 1997).

18 New York and Tennessee also have extremely active entertainment industries.

19 *White v. Samsung Elecs. Am., Inc.*, 989 F.2d 1512, 1521 (9th Cir. 1992) (Kozinski, J., dissenting) ("For better or worse we are the Court of Appeals for the Hollywood Circuit. Millions of people toil in the shadow of the law we make, and much of their livelihood is made possible by the existence of intellectual property rights.").

20 See *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

21 *Id.*

22 58 Cal. Rptr. 2d 645 (Ct. App. 1996).

protection with the right of publicity and outlines why the two provide independent protection. Finally, in Part VI, I summarize why federal copyright law alone does not afford celebrities the legal protection they deserve, and I conclude that the federal Copyright Act of 1976 does not preempt state right of publicity laws.

## II. FACTS OF *ASTAIRE V. BEST FILM & VIDEO*

In a case recently decided by the Ninth Circuit,<sup>23</sup> the estate of legendary dancer and film star Fred Astaire brought a right of publicity action against a producer of instructional dance videotapes that contained Astaire's likeness.

Fred Astaire and business partner Chester Casanave started the Fred Astaire Dance Studios in 1946.<sup>24</sup> In 1953, Astaire withdrew from the business and sold his rights under a contract that granted him a 40-year royalty from the company's revenues while reserving for Casanave the right to continue the dance instruction business. Pursuant to these agreements, Astaire gave Casanave the license to franchise dance studios under the "Fred Astaire Dance Studios" trademark and authorized particular uses of the right to market dance instructional materials using the name, image, and likeness of Fred Astaire.<sup>25</sup>

In 1965 the Fred Astaire Dance Studios Corporation changed its name to Ronby Corporation, and Astaire granted Ronby "a perpetual exclusive right and license to use . . . the name 'Fred Astaire' in connection with the conduct and operation of dance studios and schools and related activities."<sup>26</sup> On March 15, 1989, Ronby and the Best Film and Video Corporation ("Best") entered into an agreement to co-produce a series of instructional videotapes using the Fred Astaire Dance Studios' distinctive and proprietary dance curriculum.

Best produced a series of instructional dance videotapes that ranged in length from 37 to 43 minutes. Each opened with a brief introduction by a dance studio representative followed by 93 seconds of film clips taken from two Fred Astaire films, *Royal Wedding* and *Second Chorus*. The two films were originally under copyright to major motion picture studios but have long since fallen into the public domain.<sup>27</sup>

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23 *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

24 See Appellant's Opening Brief at 3, *Astaire* (No. 95-56632).

25 See *id.* at 4.

26 *Id.*

27 See Respondent's Opening Brief at 2, *Astaire* (No. 95-56632).

Best produced, distributed, advertised, and marketed the videotapes to wholesale distributors and retailers, and made available complete versions of the videotapes (known as "screeners") for advance viewing by potential buyers.<sup>28</sup> As part of its marketing campaign for the videotapes, Best gave away hundreds of copies of the videotapes to potential buyers, the media, and others for "promotional" and "screening" purposes.<sup>29</sup> In addition, Best showed the videotapes at a consumer electronics show in Chicago in the summer of 1989.<sup>30</sup> Best did not obtain permission from Mrs. Astaire or the Estate of Fred Astaire to utilize the film clips in the videotapes.<sup>31</sup>

The jacket of the videotapes identified them under the Fred Astaire Dance Studios trademark name and contained a quotation from Astaire regarding the importance of good dance instruction in learning to dance.<sup>32</sup> Defendants claimed that all advertising and marketing materials produced in conjunction with the distribution of the videotapes identified themselves only with the trademark "Fred Astaire Dance Studios."<sup>33</sup>

As Fred Astaire's widow, Robyn Astaire succeeded to all rights in Fred Astaire's name, voice, signature, photograph, likeness, and persona.<sup>34</sup> In that capacity, she sued Best and the owner of Fred Astaire Dance Studios alleging various claims, including a violation of California's right of publicity.<sup>35</sup>

The district court found Best liable for violating Astaire's right of publicity and held that federal copyright law does not preempt California's right of publicity.<sup>36</sup> In July of 1993, Ronby and Astaire settled their claims, thus leaving only the right of publicity claims against

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28 See *id.* at 4 (According to Best's president, "[t]he purpose of such dissemination is to give buyers a sense of the quality and content of the videos themselves.").

29 See *id.* at 5.

30 See *id.*

31 See *id.*

32 See *id.* at 4 n.3 (stating that Best originally asserted a defense based on the scope of Mrs. Astaire's registration statement but later stipulated that its use of the film clips was not authorized by Mrs. Astaire).

33 See Appellant's Opening Brief at 5, *Astaire* (No. 95-56632).

34 Mrs. Astaire claimed rights to Fred Astaire's name, voice, signature, photograph, and likeness by filing a Registration of Claim under CAL. CIV. CODE § 990 (West 1998).

35 Astaire brought a cause of action under § 990, which provides publicity protection for deceased celebrities. It is the companion to CAL. CIV. CODE § 3344 (West 1998) which is explained at Part III of this Note. See also Sean Elliott, Note, *Something's Weird in the State of California: How the Right of Publicity Wronged Bettie Page*, 72 NOTRE DAME L. REV. 593 (1997).

36 *Astaire v. Ronby*, CV 90-261 KN (C.D. Cal. July 7, 1991).

Best.<sup>37</sup> Best appealed from that judgment, and Astaire appealed from the portion of the judgment holding that the use by Best was not "for purposes of advertising, or selling, or soliciting purchases of products."<sup>38</sup> Of relevance to this Note is Best's claim that the district court erred in finding that California's right of publicity was not preempted by the federal Copyright Act.

That the Ninth Circuit decided the case on grounds distinct from the ruling of *Astaire* is unfortunate both for celebrities who otherwise are left without legal recourse for the misappropriation of their identities and for legal scholars, counselors, and courts who desire a logical, consistent application of the law.

### III. RIGHT OF PUBLICITY

#### A. *The Policy Promoting Publicity Rights*

The major justification for protecting a celebrity's right of publicity stems from a Lockean reverence for the labor a celebrity invests in his work.<sup>39</sup> In his *Second Treatise*, Locke avers that an individual owns a property right in his person and the labor of his body.<sup>40</sup> Melville Nimmer elaborated on Locke's argument in an influential 1954 article by contending that one who has "long and laboriously nurtured the fruit

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37 On January 10, 1994, the parties filed cross-motions for summary judgment, and on March 11, 1994, the District Court issued its ruling. In that order the court made four key findings of fact and law: (1) Best's use of Astaire's likeness as incorporated in the videotapes in itself constituted a violation of § 990 as a use "on or in . . . products, merchandise, goods, or services," (2) Best did not use Astaire's likeness in the videotapes for the purposes of advertising, selling, or soliciting purchases of the videotapes within the meaning of § 990, (3) the First Amendment does not protect Best's use of Astaire's likeness from a right of publicity claim, and (4) federal copyright law does not preempt California's right of publicity. *Id.*

38 Appellant's Opening Brief at 3, *Astaire* (No. 95-56632).

39 See JOHN LOCKE, *THE SECOND TREATISE OF GOVERNMENT* 100 (Peter Laslett ed., 2d ed. 1976) (elaborating a philosophical argument for private property based on the fruit of one's labors); see also *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1282 (D. Minn. 1970) ("A celebrity must be considered to have invested his years of practice and competition in a public personality which eventually may reach marketable status. That identity, embodied in his name, likeness, statistics and other personal characteristics, is the fruit of his labors, and is a type of property."). But see Michael Madow, *Private Ownership of Public Image: Popular Culture and Publicity Rights*, 81 CAL. L. REV. 125, 132 (1993) (questioning whether the right of publicity should even exist at all); *id.* at 174 (labeling arguments for broadening the right of publicity as "a high-class form of special-interest pleading for the star image industry").

40 LOCKE, *supra* note 39, at 100 (stating that an individual earns "a property [right] in [her] own person" and thus in the "labor of [her] body").



of publicity values" should benefit from those values himself.<sup>41</sup> Gaining a commercially exploitable value in one's identity does not come easily, as it requires considerable energy and ingenuity to both achieve and maintain celebrity status.<sup>42</sup> Thus, since the celebrity spends time, money, and energy developing a commercially lucrative persona, that persona is the fruit of the celebrity's labor and deserves the protection of the law.<sup>43</sup>

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41 Nimmer, *supra* note 2, at 216.

42 See Sheldon W. Halpern, *The Right of Publicity: Commercial Exploitation of the Associative Value of Personality*, 39 VAND. L. REV. 1199, 1239 (1986) ("Relief for the celebrity whose persona has been appropriated for a commercial endorsement is supported by the proposition that the celebrity, by dint of effort or luck, has created in his or her personality a marketable economic value distinguishable from the emotional value of identity.").

Instances do arise where an individual's identity becomes recognizable by accident, luck, or association with a negative event. For example, the affair between presidential candidate Gary Hart and Donna Rice in 1984 resulted in Ms. Rice becoming a spokesperson for No Excuses Jeans. Although Ms. Rice arguably exerted less effort and displayed less talent to achieve her celebrity status than individuals who perform for a career and she did not necessarily strive to achieve a publicly identifiable persona, Ms. Rice would be entitled to publicity rights in her persona to the extent that it became marketable or misappropriated in conjunction with future commercial uses.

This protection of her celebrity status would be merited based on her resulting loss of privacy and other encumbrances that accompany celebrity status. Furthermore, market forces and economic considerations usually limit the duration of celebrity status for accidental celebrities since, unless Ms. Rice continues sleeping with politicians, public interest in her will probably wane earlier than the status of one who continually practices, works, and exerts new talents for a public audience.

43 Some scholars question the legitimacy of the celebrity's proprietary interest in the self. See, e.g., Edwin C. Hettinger, *Justifying Intellectual Property*, 18 PHIL. & PUB. AFF. 31, 37-40 (1989) (remarking that although the celebrity invests time, effort, skill, and money in developing her image, it does not follow that all of her value is attributable to her labor because her creation occurs in social context and draws upon other resources, institutions, and technologies); see also RICHARD DYER, *HEAVENLY BODIES: FILM STARS AND SOCIETY* (1986) (arguing that the consumers and the producers make a celebrity image a unique phenomenon); David Lange, *Recognizing the Public Domain*, 44 LAW & CONTEMP. PROBS. 147, 155-58 (1981) (questioning the reasoning that the celebrity needs to have control over her identity through exclusive property rights in order to protect her commercial value and expressing concern that such a right is encroaching upon the "public domain").

It might also be argued that an entertainer's initial salary is sufficient to compensate the artist for his or her work, but salary compensates an individual for his talent and commercial worth at the time certain work is done and does not compensate the individual for future unconsented-to uses of his identity.

For example, Jennifer Beals was paid for her portrayal of a struggling dancer in the film *FLASHDANCE* (Paramount Pictures Corp. 1983). Beals was paid at the rate of her unknown identity at the time she played the role, but her persona became more recognizable after that role. Thus, her salary for that one work would not compensate

Most courts and commentators define the right of publicity as a form of intellectual property,<sup>44</sup> so the celebrity should have exclusive control of his or her right of publicity. Using a celebrity's persona for the unauthorized commercial gain of another compares to pirating the celebrity's product,<sup>45</sup> so recognizing a right of publicity in one's identity becomes the most certain way of protecting celebrities from unauthorized commercial exploitation.<sup>46</sup> Thus, protecting a celebrity's persona affords protection against businesspersons and the like improperly reaping rewards from the hard work and endeavors the artist has sown. A final reason to protect the celebrity's identity is to grant the artist exclusive control of his or her persona in order to protect consumers from possible misrepresentation, deception, and false endorsements.<sup>47</sup>

Attaining a commercial value in one's identity requires trading one's personal life and privacy for the relentless cravings of the public imagination. The right of publicity grants the creative individual an ownership interest in his or her intangible name, likeness, or identity. Furthermore, protection of publicity rights rewards those in the public arenas for their hard work and personal sacrifices<sup>48</sup> and encour-

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her for a sweatshirt company using the familiar shoulder-exposed pose of Beals from the film.

Furthermore, the *Flashdance* role may have been as much a vexation as a blessing. Beals, an advocate of independent films, does not necessarily want to be known solely for her ultra-commercial role as an '80s dancer, so she must have the ability to preclude others from the unconsented use of her persona. Salary is simply not sufficient to accomplish these goals and provide such protection. Telephone Interview with Erin O'Donell, Assistant to Jennifer Beals (Apr. 3, 1997).

44 See Pemberton, *supra* note 5, at 113 n.56 (citing J. THOMAS MCCARTHY, *THE RIGHTS OF PUBLICITY AND PRIVACY* § 10-7 to -8 (1993)).

45 See *American Econ. Ins. Co. v. Reboans, Inc.*, 852 F. Supp. 875 (N.D. Cal. 1994) (stating that using an individual's persona for the unauthorized commercial gain of another compares to stealing another's product and passing it off as coming from the misappropriator's source).

46 Pirating another's product is usually not unlawful, absent passing it off as one's own. See *Sears v. Stiffel Co.*, 376 U.S. 225 (1964). Nonetheless, infringing on publicity rights involves misappropriating the celebrity's persona in such a manner as to create confusion that the celebrity endorses the product in question. See James M. Left, *Not for Just Another Pretty Face: Providing Full Protection Under the Right of Publicity*, 11 U. MIAMI ENT. & SPORTS L. REV. 321, 372 (1994).

47 See, e.g., Lisa A. Lawrence, *The Right of Publicity: A Research Guide*, 10 HASTINGS COMM. & ENT. L.J. 143, 369-77 (1987) (discussing intellectual property rights); Madow, *supra* note 39, at 228-36 (analyzing the rationale behind the consumer protection argument for publicity rights).

48 For example, although Laurence Fishburne had been acting since long before doing *Apocalypse Now* in the mid-1970s, it was not until the 1990s with films such as *Boyz in the Hood*, *What's Love Got to Do with It*, and *Searching for Bobby Fisher* that he

ages those with unusual talent to endure the hardships and humiliation of their occupation.<sup>49</sup> Thus, the celebrity deserves the protection, security, and many advantages, economic or otherwise, provided by the right of publicity.

### B. *Nature and Scope of California's Right of Publicity*

The modern right of publicity originated as an element of the right of privacy<sup>50</sup> but has since evolved into a distinct cause of action recognized in the majority of jurisdictions in the United States.<sup>51</sup> The right of privacy is rooted in a law review article written over a century ago by Louis D. Brandeis and Samuel D. Warren,<sup>52</sup> and the landmark decision of *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*<sup>53</sup> then allowed the transition from the right of privacy to the right of publicity. *Haelan* held that, "in addition to and independent of the right of privacy . . . [a celebrity] has a right in the publicity value of his photograph . . . . This right might be called a 'right of publicity.'"<sup>54</sup>

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achieved mega-star status. Interview with Sam Gores, Laurence Fishburne's Agent, Century City, California (Nov. 21, 1997).

49 See Elliott, *supra* note 35, at 630.

50 See William L. Prosser, *Privacy*, 48 CAL. L. REV. 383 (1960) (stating that four torts comprise the right of privacy: (1) intrusion upon the plaintiff's seclusion or solitude, or into his private affairs, (2) public disclosure of embarrassing private facts about the plaintiff, (3) publicity which places the plaintiff in a false light in the public eye, and (4) appropriation, for defendant's advantage, of the plaintiff's name or likeness—this fourth tort has evolved into the right of publicity).

51 See FLA. STAT. ANN. § 540.08 (West 1997); KY. REV. STAT. ANN. § 391.170 (Banks-Baldwin 1997); MASS. ANN. LAWS ch. 214, § 3A (Law. Co-op 1986); NEB. REV. STAT. ANN. § 20-202 to -208 (Michie 1991); N.Y. CIV. RIGHTS LAW §§ 50-51 (McKinney 1992); OKLA. STAT. ANN. tit. 21, § 839.1-3 (West 1983); R.I. GEN. LAWS §9-1-28 (1997); TENN. CODE ANN. §47-25-1101 to -1108 (1995); UTAH CODE ANN. §45-3-1 to -6 (1993); VA. CODE ANN. § 8.01-40 (Michie 1992); WIS. STAT. ANN. § 895.50 (West 1997); *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562, 566 (1977); *Carson v. Here's Johnny Portable Toilets*, 698 F.2d 831, 834 (6th Cir. 1983); *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 220 (2d Cir. 1978); *Cepeda v. Swift & Co.*, 415 F.2d 1205, 1206 (8th Cir. 1969); *Philadelphia Orchestra Ass'n v. Walt Disney Co.*, 821 F. Supp. 341, 349 (E.D. Pa. 1993); *Estate of Presley v. Russen*, 513 F. Supp. 1339, 1354 (D.N.J. 1981); *Uhlaender v. Henricksen*, 316 F. Supp. 1277, 1281 (D. Minn. 1970); *Lugosi v. Universal Pictures*, 603 P.2d 425, 428 (Cal. 1979); *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. American Heritage Prods. Inc.*, 296 S.E.2d 697, 702 (Ga. 1982); *Hirsch v. S.C. Johnson & Son, Inc.*, 280 N.W.2d 129 (Wis. 1979).

52 Louis D. Brandeis & Samuel D. Warren, *The Right to Privacy*, 4 HARV. L. REV. 193 (1890).

53 202 F.2d 866 (2d Cir. 1953).

54 *Id.* at 868.

A year later, Professor Melville B. Nimmer<sup>55</sup> wrote an influential article advocating the adoption of a property-based right of publicity. The right of publicity doctrine progressively gained widespread acceptance in numerous jurisdictions<sup>56</sup> as the United States Supreme Court recognized the right of publicity as a valid cause of action in *Zacchini v. Scripps-Howard Broadcasting Co.*<sup>57</sup>

In 1971, the California legislature passed Civil Code § 3344 to protect against misappropriation of one's persona. It holds any person who uses another's name, photograph, or likeness for advertising purposes without the other person's consent liable for any injury sustained.<sup>58</sup> To fulfill the statutory cause of action, therefore, the plaintiff must prove that the defendant knowingly used the plaintiff's identity and did so for purposes of advertising or soliciting purchases. Furthermore, the plaintiff must show that the defendant's use directly relates to that commercial purpose.

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55 Nimmer, *supra* note 2, at 203.

56 See, e.g., *Carson*, 698 F.2d at 836 (holding that an intentional appropriation of another's identity for "commercial exploitation" violates the right of publicity); *Zim v. Western Publ'g Co.*, 573 F.2d 1318, 1327 (5th Cir. 1978) (acknowledging that embodied within the right of privacy is the "right to control the use of [one's own] name for commercial purposes"); *Motschenbacher v. R.J. Reynolds Tobacco Co.*, 498 F.2d 821, 825 (9th Cir. 1974) (granting "legal protection to an individual's proprietary interest in his own identity"); *Cepeda*, 415 F.2d at 1206 (stating that it is settled law that a person "has a valuable property right in his name, photograph and image"); *Estate of Presley*, 513 F. Supp. at 1359 (extending the right of publicity to fiction in the form of theatrical imitations where the end result was commercial exploitation of the public figure and where the imitation "contribute[d nothing] of substantial value to society"); *Uhlaender*, 316 F. Supp. at 1282 (holding "that a celebrity has a legitimate proprietary interest in his public personality . . . embodied in his name, likeness, statistics and other personal characteristics"); *Martin Luther King, Jr., Ctr. for Soc. Change, Inc.*, 296 S.E.2d at 705 (extending the right of publicity afforded entertainers and public officials to "public figures" and holding that such a right "survives the death of its owner and is inheritable and devisable"); *Lombardo v. Doyle, Dane & Bernbach, Inc.*, 396 N.Y.S.2d 661, 665 (App. Div. 1977) (finding a television commercial's unfair and deceptive imitation of a person's public personality as violating his right to publicity). But see *Lugosi*, 603 P.2d at 431 (holding that the right to exploit name and likeness must be exercised by individual during his lifetime); *Stephano v. News Group Publications, Inc.*, 474 N.E.2d 580, 584 (N.Y. 1984) (refusing to recognize publicity right as separate from privacy right).

57 433 U.S. 562 (1977).

58 California's right of publicity statute was amended in 1984 and currently states, "Any person who knowingly uses another's name, voice, signature, photograph, or likeness, in any manner . . . for purposes of advertising or selling . . . without such person's prior consent . . . shall be liable for any damages sustained by the person or persons injured as a result thereof." CAL. CIV. CODE § 3344(a) (West 1998).

Recovery for misappropriation of name or likeness under California Civil Code § 3344 does not provide the exclusive means of protecting a person's identity from unauthorized commercial appropriation. The statute expressly states, "[t]he remedies provided for in this section are cumulative and shall be in addition to any others provided for by law." Thus, § 3344 complements, rather than codifies, the common law approach to misappropriation.<sup>59</sup>

California authoritatively recognized a common law right of publicity in *Eastwood v. Superior Court*,<sup>60</sup> in which movie legend Clint Eastwood alleged that the tabloid paper *National Enquirer* misappropriated his name and likeness. He stated claims under both statutory and common law misappropriation, and the *Eastwood* court delineated four elements required for infringement of the right of publicity: "(1). the defendant's use of the plaintiff's identity; (2). the appropriation of the plaintiff's name or likeness to defendant's advantage, commercially or otherwise; (3). lack of consent; and (4). resulting injury."<sup>61</sup>

Thus, an action at common law in California presents a less onerous burden than an action under California Civil Code § 3344(a) since the plaintiff need prove neither a knowing use of his persona nor a direct connection between the use and a commercial purpose.<sup>62</sup> Another distinction between the California statutory and common law approaches concerns the scope of the protection. A Ninth Circuit decision expanded the common law right of publicity beyond the statutory confines of an individual's actual name or likeness to protect even the evocation of a celebrity's persona from any unauthorized exploitation.<sup>63</sup>

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59 Additionally, *id.* § 990 is the companion statute to § 3344 for deceased individuals. Section 990 formed the basis for the cause of action in *Astaire*, and its application in that context is discussed at *supra* Part II and *infra* Part V(D) of this Note.

60 198 Cal. Rptr. 342 (Ct. App. 1983).

61 *Id.* at 347, *quoted in* *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 640 (Ct. App. 1995).

62 Despite the more rigorous standards of § 3344, the statutory cause of action provides for the recovery of attorney's fees for the successful plaintiff, whereas the common law does not. As a result, plaintiffs will bring both statutory and common law causes of action.

63 See *White v. Samsung Elecs. Am., Inc.*, 971 F.2d 1395, 1398 (9th Cir. 1992) ("The right of publicity does not require that appropriation of identity be accomplished through particular means to be actionable.").

## IV. THE COPYRIGHT ACT OF 1976 AND THE RIGHT OF PUBLICITY

A. *Policy Underlying Copyright Law*

Since the early 1550's English copyright was a private law concept, called the stationer's copyright, that was used as an instrument of both monopoly and press control. In 1710 the Statute of Anne<sup>64</sup> was enacted to ensure that the statutory copyright would be used for neither purpose,<sup>65</sup> and it led to the end of the stationer's company publishing monopoly and almost certainly provided the basis of the intellectual property clause of the United States Constitution.<sup>66</sup>

The modern copyright promotes a system where the grant of rights to authors promotes creativity and benefits public welfare.<sup>67</sup> The Supreme Court has recognized this rationale by stating, "[t]he economic philosophy behind the clause empowering Congress to grant patents and copyrights is the conviction that encouragement of individual effort by personal gain is the best way to advance public welfare through the talents of authors and inventors in 'Science and useful Arts.'"<sup>68</sup>

More recently, the Court has stated, "[t]he monopoly privileges that Congress may authorize . . . [are] intended to motivate the creative activity of authors and inventors by the provision of a special reward, and to allow the public access to the products of their genius after the limited period of exclusive control has expired."<sup>69</sup> Thus, the purpose of copyright is to allow the individual creator a temporary monopoly over the subject matter of his or her tangible creation in order to foster the inventions and ingenuity of creators. The right of publicity, on the other hand, exceeds that by granting the creative individual an ownership interest in his or her intangible name, likeness, or identity. Therefore, the goals and purposes are similar, but they are not equivalent.

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64 8 Anne, ch. 21 (1710).

65 See L. Ray Patterson & Craig Joyce, *Monopolizing the Law: The Scope of Copyright Protection for Law Reports and Statutory Compilations*, 36 UCLA L. REV. 719, 784-85 (1989).

66 See Lyman Ray Patterson, *The Statute of Anne: Copyright Misconstrued*, 3 HARV. J. ON LEGIS. 223, 228 (1966); Paul Heald, *Federal Intellectual Property Law and the Economics of Preemption*, 76 IOWA L. REV. 959, 963 (1991).

67 See Heald, *supra* note 66, at 959.

68 Mazer v. Stein, 347 U.S. 201, 219 (1954).

69 Sony Corp. of Am. v. Universal City Studios, Inc., 464 U.S. 417, 429 (1984).

*B. Federal Preemption of Analogous Rights*

State laws are subject to preemption under the supremacy clause of the United States Constitution<sup>70</sup> if the state law "actually conflicts with a valid federal statute" or "stands as an obstacle to the accomplishment and execution of the full purposes and objectives of Congress."<sup>71</sup> Furthermore, Congress, when it acts within constitutional limits, is empowered to preempt state laws when it states so in express terms.<sup>72</sup> The intellectual property clause of the United States Constitution expressly grants Congress the power to "promote the Progress of Science and useful Arts, by securing for limited Times to Authors . . . the exclusive Right to their . . . Writings."<sup>73</sup>

Thus, this clause entitles Congress to enact legislation governing all "writings," and the United States Supreme Court defines writings "to include any physical rendering of the fruits of creative intellectual or aesthetic labor."<sup>74</sup> Therefore, preemption of state publicity rights is ultimately controlled by the intellectual property clause of the United States Constitution which grants Congress the power to enact legislation governing all "physical rendering of the fruits of creative intellectual or aesthetic labor."<sup>75</sup>

The relationship between state laws and federal intellectual property laws was examined in several Supreme Court decisions that preceded the enactment of the 1976 Copyright Act. In *Sears Roebuck, Inc. v. Stiffel Co.*<sup>76</sup> and *Compco Corp. v. Day-Brite Lighting, Inc.*,<sup>77</sup> the Court held that a state's unfair competition law cannot prohibit the copying of an article that is not entitled to protection under federal patent law. According to the Court, "[t]o allow a State by use of its law of unfair competition to prevent the copying of an article which represents too slight an advance to be patented would be to permit the State to block off from the public something which federal law has said belongs to the public."<sup>78</sup>

Two subsequent Supreme Court cases refined and elucidated the approach adopted in *Sears* and *Compco*. Federal patent law was held

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70 U.S. CONST. art. I, § 8, cl. 8 (giving Congress the power "[t]o promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries").

71 *Edgar v. MITE Corp.*, 457 U.S. 624, 631 (1982) (citations omitted).

72 *See California Fed. Sav. & Loan Ass'n v. Guerra*, 479 U.S. 272, 280 (1986).

73 U.S. CONST. art. I, § 8, cl. 8.

74 *Goldstein v. California*, 412 U.S. 546, 561 (1973).

75 *Id.*

76 376 U.S. 225 (1964).

77 376 U.S. 234 (1964).

78 *Sears Roebuck*, 376 U.S. at 231-32.

not to preempt a state's trade secret laws in *Kewanee Oil v. Bicron Corp.*<sup>79</sup> The Court examined the objectives of both patent and trade secret laws and concluded that the two were not inconsistent.

While the trade secret laws protected items such as customer lists that would not be considered patentable, the Court held that Congress had "left the area unattended" with respect to such nonpatentable subject matter.<sup>80</sup> The existence of another form of "incentive to invention" was deemed not to disturb the patent policy of encouraging the creation of new products and processes.<sup>81</sup> The Court thus concluded that "[until] Congress takes affirmative action to the contrary, States should be free to grant protection to trade secrets."<sup>82</sup>

This same approach was employed by the United States Supreme Court in *Goldstein v. California*,<sup>83</sup> which rejected a preemption challenge to a state criminal statute that prohibited the unauthorized duplication of sound recordings. In resolving the issue, the Court held that the Constitution does not preclude states from granting copyrights and does not vest such authority exclusively in the federal government.<sup>84</sup> Thus, in seeking to determine whether federal copyright law preempts right of publicity laws of the states, courts must determine whether Congress has taken "affirmative action contrary" to the common law right of publicity.

Section 301 of the Copyright Act of 1976 expressly prohibits states from legislating in the area of copyright law. It provides:

On or after January 1, 1978, all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of the copyright as specified by §106 . . . are governed exclusively by this title. Thereafter, no person is entitled to such right or equivalent right in any such work under the common law or statutes of any State.<sup>85</sup>

Section 301 may be broader than pre-1978 law since, for instance, it abolished common law copyright altogether, whereas the predecessor act did not express that contention and instead relied on the supremacy clause for the distinction. Nonetheless, Professor Nimmer has observed, and courts have agreed,<sup>86</sup> that the scope of preemption under § 301 of the 1976 Act is basically comparable to that under the

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79 *Kewanee Oil v. Bicron Corp.*, 416 U.S. 470, 483 (1974).

80 *Id.*

81 *Id.* at 493.

82 *Id.*

83 412 U.S. 546 (1973).

84 *Id.*

85 17 U.S.C. § 301(a) (1994).

86 *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1099 (S.D.N.Y. 1980).



1909 Act as interpreted by *Goldstein*.<sup>87</sup> In Nimmer's view, § 301 merely codified *Goldstein* with respect to works published before January 1, 1978, the effective date of the 1976 Act. Under this interpretation, the 1976 Act's preemption provision could be applied to pre-1978 publications and preempt plaintiffs from bringing many actions under state law.<sup>88</sup>

Since § 301 provides that the federal copyright law preempts "all legal or equitable rights that are equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106," the 1976 Copyright Act preempts a state cause of action that meets three conditions: (1) equivalence to any of the exclusive rights within the general scope of copyright (2) in a work of authorship that is fixed in a tangible medium of expression, and (3) within the subject matter of copyright.<sup>89</sup>

The House Report on the 1976 Act declares that § 301's preemptive principle "is intended to be stated in the clearest and most unequivocal language possible, so as to foreclose any conceivable misinterpretation of its unqualified intention that Congress shall act preemptively, and to avoid the development of any vague borderline areas between State and Federal protection."<sup>90</sup> Although Congress' preemptive purpose is clear, the language of § 301 is not. Dispute exists as to the meaning of two of § 301(a)'s three conditions for preemption—that the state right be equivalent to copyright, and that the subject matter of the state right come within the subject matter of copyright. Some confusion also surrounds § 301(b)'s exclusion of certain rights from preemption.<sup>91</sup>

## 1. Equivalent Rights

The first condition required for preemption under § 301(a) is that the state right at issue be a "legal or equitable" right that is "equivalent to any of the exclusive rights within the general scope of

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87 1 MELVILLE H. NIMMER & DAVID NIMMER, NIMMER ON COPYRIGHT, § 1.01[B] at 1-9 n.31 (1997); see also PAUL GOLDSTEIN, COPYRIGHT, PATENT, TRADEMARK AND RELATED STATE DOCTRINES, CASES AND MATERIALS ON THE LAW OF INTELLECTUAL PROPERTY, 802-03 (4th ed. 1997) (stating that preemption of state law publicity rights would seem to be governed by *Goldstein* which held that categories of expression not listed in the Copyright Act were eligible for state protection because Congressional silence was not to be interpreted as a prohibition on protection).

88 17 U.S.C. § 301(a).

89 See GOLDSTEIN, *supra* note 88, at 802-03.

90 H.R. REP. NO. 94-1476, at 132 (1976), reprinted in 1976 U.S.C.C.A.N. 5659, 5748.

91 See GOLDSTEIN, *supra* note 88, at 803-04.

copyright as specified by section 106.”<sup>92</sup> Section 106 states the exclusive rights in copyrighted works as follows:

[T]he owner of copyright under this title has the exclusive rights to do and to authorize any of the following:

to reproduce the copyrighted work . . . ;

to prepare derivative works based upon the copyrighted work;

to distribute copies . . . of the copyrighted work to the public by sale or other transfer of ownership, or by rental, lease, or lending;

. . . to perform the copyrighted work publicly; and

. . . to display the copyrighted work publicly.<sup>93</sup>

Thus, a state right will be preempted if it attaches to a tangibly fixed work of authorship coming within the subject matter of copyright and is equivalent to the right to reproduce the work, to prepare derivative works based upon the work, to distribute copies of the work publicly, to perform the work publicly, or to display the work publicly.<sup>94</sup> A state law right is equivalent to copyright for the purposes of §301 if (1) the right encompasses conduct coming within the scope of one or more of § 106’s exclusive rights, and (2) if applicable state law requires the plaintiff to prove no more than the elements that the Copyright Act requires for proof of infringement of one or more of § 106’s five exclusive rights.<sup>95</sup>

#### a. State Rights within General Subject Matter of Copyright

The equivalence of state laws in § 301 are measured against “the exclusive rights within the general scope of copyright as specified by section 106.”<sup>96</sup> The “general scope of copyright” means the full scope that Congress could have described for any particular right<sup>97</sup> and is met when the work of authorship being copied “[falls] within the ambit of Federal protection.”<sup>98</sup> Thus, under the general scope requirement, § 301 “preempts only those state law rights that ‘may be

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92 17 U.S.C. § 301(a) (1994).

93 *Id.* § 106.

94 *See id.* § 301.

95 *See* GOLDSTEIN, *supra* note 88, at 803–04.

96 H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748. Also, “[t]he preemption of rights under State Law is complete with respect to any work coming within the scope of the bill, even though the scope of exclusive rights given the work under the bill is narrower than the scope of common law rights in the work might have been.” *Id.* at 5747.

97 *See* GOLDSTEIN, *supra* note 88, at 805–06.

98 *Harper & Row, Inc. v. Nation Enters.*, 723 F.2d 195, 200 (2d Cir. 1983), *rev’d on other grounds*, 471 U.S. 539 (1985).

abridged by an act which, in and of itself, would infringe one of the exclusive rights' provided by federal copyright law."<sup>99</sup>

For example, the general scope of copyright includes § 106(4)'s exclusive right to perform a work, so any state right that prohibits performance will be considered an equivalent right. Although § 106(4) limits the right to public performances, a state law that prohibited private performances as well would come within the general scope of the right because the state right would fall within the general ambit of the performance right.<sup>100</sup> Thus, the state law would be preempted.<sup>101</sup>

#### b. State Rights Containing No Extra Elements

A state right is not equivalent to copyright, and thus is not subject to preemption, if the state cause of action contains an operative element that is absent from the cause of action for copyright infringement.<sup>102</sup> Thus, if an extra element is "required instead of or in addition to acts of reproduction, performance, distribution, or display, in order to constitute a state-created cause of action, then the right is not within the general scope of copyright and is not preempted."<sup>103</sup>

As stated above, California's common law right of publicity requires the elements of defendant's use of the plaintiff's identity, appropriation of plaintiff's name or likeness to defendant's advantage, lack of consent, and resulting injury.<sup>104</sup> Furthermore, California's statutory cause of action requires the additional elements of the de-

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99 *Computer Assoc. Int'l, Inc. v. Altai, Inc.*, 982 F.2d 693, 716 (2d Cir. 1992) (citing *Harper & Row*, 723 F.2d at 200).

100 Nonetheless, a state law addressing solely private performances arguably would not constitute a right within the general subject matter of federal copyright law.

101 See GOLDSTEIN, *supra* note 88, at 804-05.

102 See *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1100 (9th Cir. 1992) (stating that claims are not preempted by federal copyright statute as long as they "contain elements, such as an invasion of personal rights . . . that are different in kind from copyright infringement" and that the unauthorized commercial use of one's identity is an invasion of a "personal property right," different in kind than copyright infringement); see also H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748.

103 H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 ("The evolving common law rights of 'privacy,' 'publicity,' and trade secrets . . . would remain unaffected [by § 301 and federal preemption] as long as the causes of action contain elements . . . that are different in kind from copyright infringement."); see also *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1099 (S.D.N.Y. 1980); MELVILLE H. NIMMER, *NIMMER ON COPYRIGHT*, § 1.10[B] at 1-11 (1978).

104 See *Montana v. San Jose Mercury News, Inc.*, 40 Cal. Rptr. 2d 639, 640 (Ct. App. 1995) (quoting *Eastwood v. Superior Court*, 198 Cal. Rptr. 342 (Ct. App. 1983)).

fendant knowingly using plaintiff's persona and the existence of a direct connection between the use and a commercial purpose.<sup>105</sup> Thus, since the state right of publicity cause of action, in addition to being infringed by reproduction, distribution, or display, also requires a minimum demonstration that the defendant profited by injuring the plaintiff's intangible, publicly recognizable identity, the right of publicity requires extra elements beyond those of copyright law, and therefore evades preemption. Furthermore, as stated by the Second Circuit and the Southern District of New York, the exploitation of a celebrity's name and image during his lifetime creates an "intangible property right"<sup>106</sup> that "is not 'equivalent' to a copyright and requires elements distinct from a copyright violation suit."<sup>107</sup>

Thus, state rights that require elements beyond those required for infringement of copyright are not preempted. The right of publicity is such a law.

c. State Rights Specifically Enumerated as Exempt from  
Preemption Under the Original Form of the Copyright  
Act of 1976

The drafters of the 1976 Copyright Act originally included several examples of states' laws that would not be preempted by § 301,<sup>108</sup> but

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105 Despite the more rigorous standards of § 3344, the statutory cause of action provides for the recovery of attorney's fees for the successful plaintiff, whereas the common law does not. As a result, plaintiffs will bring both statutory and common law causes of action.

106 *Factors Etc., Inc. v. Pro Arts, Inc.*, 579 F.2d 215, 221 (2d Cir. 1978).

107 *Factors Etc.*, 496 F. Supp. at 1100.

108 See H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 (stating that § 301(b)(3), as submitted to Congress in 1965, exempted activities violating rights that are not equivalent to any of the exclusive rights within the general scope of copyright as specified by § 106, including breaches of contract, breaches of trust, invasion of privacy, defamation, and deceptive trade practices such as passing off and false representation). In the version that went to the floor of the House in 1976, § 301(b)(3) included three more examples of exempted state doctrines—trespass, conversion, and "rights against misappropriation not equivalent to any of such exclusive rights [within the general scope of copyright as specified by § 106]." *Id.* According to the 1976 House Report, "[m]isappropriation is not necessarily synonymous with copyright infringement, and thus a cause of action labeled as 'misappropriation' is not preempted if it is in fact based neither on a right within the general scope of copyright as specified by section 106 nor on a right equivalent thereto." *Id.*

This change departs from the position that the House Report took on misappropriation in the 1965 bill. According to that report, "where the cause of action involves the form of unfair competition, commonly referred to as misappropriation, which is nothing more than copyright protection under another name, § 301 is intended to have preemptive effect." *Id.*

a last minute amendment from the floor of the House removed all of the state law examples listed in § 301.<sup>109</sup>

The amendment striking the state law examples leaves some doubt about the continued relevance of these examples in construing § 301's reference to "equivalent" state doctrines. However, courts should refer to these doctrines as examples of un-preempted state laws since in one form or another the examples had been associated with § 301 from the beginning, and the extra elements test apparently underlay the drafter's selection of these deleted examples.

## 2. Fixed in a Tangible Medium of Expression

Section 301's second requirement for preemption of state law is that the state right be in "works of authorship that are fixed in a tangible medium of expression." Statutory copyright does not extend to works that have not been fixed in a tangible medium of expression, so unfixed works are left to the states. In contrast to copyright protection for expressions reduced to a tangible form, the product at issue in a right of publicity case is an individual's intangible persona.<sup>110</sup> Stating that Congress considered the right of publicity "to be immune from preemption," Professor Nimmer asserts that "[invasion] of privacy and defamation may sometimes occur by acts of reproduction,

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109 The amendment was evidently prompted by a letter from the Justice Department:

While misappropriation is almost certain to nullify preemption, any of the cause of action listed in paragraph (3) following the phrase 'as specified by § 106' may be construed to have the same effect. For example, a court could construe the copyright of an uncopyrighted published book to be an invasion of the author's right to privacy, i.e., the right to keep the control of the publication of his book privately to himself.

Quoted in Henry David Fetter, *Copyright Revision and the Preemption of State "Misappropriation" Law: A Study in Judicial and Congressional Interaction*, 25 BULL. COPYRIGHT SOC'Y, USA 367, 423 (1978).

Discussion of the amendment on the House floor clouded the amendment's meaning as its sponsor suggested that the amendment merely intended to subject misappropriation doctrine to preemption and a subcommittee member responded that the amendment would leave misappropriation and the other cited examples of state law untouched. When the amendment's sponsor subsequently acceded to this understanding, the subcommittee chair stated that the amendment would in fact preempt misappropriation doctrine and possibly other cited state doctrines as well. 122 CONG. REC. 32105 (1976) (statements of Reps. Seiberling and Railsback).

110 See *Factors, Etc., Inc. v. Creative Card Co.*, 444 F. Supp. 279, 283 (S.D.N.Y. 1977).

distribution, performance, or display, but the essence of those torts does not lie in such acts."<sup>111</sup>

### 3. Within the Subject Matter of Copyright

Section 301's third requirement for preemption is that the work of authorship subject to the state right must "come within the subject matter of copyright as specified by sections 102 and 103." Interestingly, neither § 102 nor § 103 defines the "subject matter of copyright."<sup>112</sup>

Section 102(a) only defines copyright subject matter as "original works of authorship fixed in any tangible medium of expression"<sup>113</sup> and lists eight categories of "works of authorship." Section 102(b) provides that "copyright protection for an original work of authorship does not extend to any idea, procedure, process, system, method of operation, concept, principle, or discovery, regardless of the form in which it is described, explained, illustrated, or embodied in such work,"<sup>114</sup> and § 103 adds only that the subject matter of copyright specified by § 102 includes compilations and derivative works.<sup>115</sup>

Thus, § 301's subject matter test provides an interesting interplay between sections 301(a) and 102(b) since it could either be understood that § 102(b) says that procedures, processes, and similar ideas are not the subject matter of copyright, or that these elements come within the scope of copyright subject matter but that the Act withholds protection from them. The first interpretation would allow

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111 NIMMER, *supra* note 104, § 1.10[B] at 1-13 and n.49; *see also Factors, Etc.*, 496 F. Supp. at 1099.

112 GOLDSTEIN, *supra* note 88, at 809.

113 Section 102 lists the eight categories of authorship as follows:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recording; and
- (8) architectural works.

17 U.S.C. § 102 (1994).

114 *Id.* § 102(b).

115 *Id.* § 103.

states to protect procedures, processes, and similar ideas, but the second interpretation would prohibit states from protecting these elements, if fixed, through rights equivalent to copyright.<sup>116</sup>

Thus, the following conclusions can be made concerning § 301 and federal preemption: (1) a state law which protects subject matter not listed in 17 U.S.C. sections 102(a) or 103(a) is not preempted, (2) a state law may only protect subject matter listed in § 102(a) by requiring the plaintiff to prove the additional elements of an independent cause of action, and (3) a state law which protects subject matter listed in § 102(a) without requiring proof of additional elements is preempted whether it extends protection which is broader, narrower, or the same as extended under federal law.<sup>117</sup> These conclusions are consistent with the language of § 301, its legislative history, and the goals of copyright law.

## V. INDEPENDENCE OF THE FEDERAL COPYRIGHT AND STATE RIGHT OF PUBLICITY LAWS

### A. *The United States Supreme Court*

Many courts and commentators have addressed the issue of potential preemption of the right of publicity. The United States Supreme Court addressed the issue in *Zacchini v. Scripps-Howard Broadcasting*.<sup>118</sup> Hugo Zacchini was an entertainer who performed fifteen-second "human cannonball" acts. A freelance reporter videotaped Zacchini's act, and the video clip of Zacchini's entire performance was aired on the news.<sup>119</sup> Zacchini alleged that the broadcast of his entire act was an unlawful appropriation of his property.<sup>120</sup>

The Ohio Supreme Court applied Ohio's state law based on Zacchini's "right to publicity value of his performance"<sup>121</sup> and ruled against Zacchini based on a First Amendment right to broadcast the performance.<sup>122</sup> The United States Supreme Court found no impediment to Ohio providing Zacchini with the "right to publicity value of his performance"<sup>123</sup> and went on to state, "[t]he Constitution does not prevent Ohio from making a similar choice here in deciding to

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116 See GOLDSTEIN, *supra* note 88, at 809.

117 See Heald, *supra* note 66, at 994.

118 433 U.S. 562 (1977).

119 *Id.* at 564.

120 *Id.*

121 *Id.* at 565.

122 *Id.* at 566-67.

123 *Id.* at 565.

protect the entertainer's incentive in order to encourage the production of this type of work."<sup>124</sup>

Furthermore, the *Zacchini* Court, citing the language of *Kewanee Oil*, stated, "States may hold diverse viewpoints . . . in protecting intellectual property relating to the subject matter of copyright. The only limitation on the States is that in regulating the area of patents and copyrights they do not conflict with the operation of the laws in this area passed by Congress . . . ." <sup>125</sup>

Thus, although the 1976 Copyright Act was not yet in effect, the *Zacchini* Court expressly mentioned the possibility of federal preemption, yet held that the state right of publicity was not preempted by federal law.

### B. California and Ninth Circuit Courts

Two years after *Zacchini*, the Supreme Court of California heard the case of *Lugosi v. Universal Pictures*,<sup>126</sup> in which the heirs of Bela Lugosi claimed that Universal Pictures had misappropriated Lugosi's likeness by licensing the "uniquely individual likeness and appearance of Bela Lugosi in the role of Count Dracula"<sup>127</sup> without Lugosi's or his heirs' consent.

As in *Zacchini*, the *Lugosi* case preceded the applicability of the 1976 Copyright Act, and, although the majority opinion did not address the preemption issue, Chief Justice Bird's dissent indicated that congressional action had not preempted the recognition of the common law right of publicity.<sup>128</sup> Chief Justice Bird adopted *Goldstein's* definition of a writing as "any physical rendering of the fruits of creative intellectual or aesthetic labor"<sup>129</sup> and then stated:

The intangible proprietary interest protected by the right of publicity simply does not constitute a writing. That interest may be valuable due to the individual's creative intellectual labors, but the publicity value generated by these labors is not focused in a "physical rendering." To conclude that the right of publicity is subject to congressional regulation under the copyright clause is to find that not only an author's writings, but also his mind, are subject to such control. Such a position is untenable. Thus, congressional action

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124 *Id* at 577.

125 *Id.* at 577-78 n.13 (citing *Kewanee Oil v. Bicorn Corp.*, 416 U.S. 470, 479 (1974)).

126 603 P.2d 425 (Cal. 1979).

127 *Id.* at 427.

128 *Id.* at 448.

129 *Id.* (quoting *Goldstein v. California*, 412 U.S. 546, 561 (1973)).



has not preempted the recognition of common law protection for the right of publicity.<sup>130</sup>

Finally, as if there could be a more straightforward means of stating that federal copyright law does not preempt the state right of publicity, Chief Justice Bird stated, "Any doubt on this issue was removed by . . . *Zacchini* . . . . If federal copyright law does not preclude a state from granting protection to an uncopyrighted performance, a fortiori the recognition of common law protection for the proprietary interest in one's name and likeness is immune from such attack."<sup>131</sup> Thus, although the majority opinion of the California Supreme Court did not address the preemption issue, Chief Justice Bird's dissent indicated that congressional action had not preempted the recognition of the common law right of publicity.

The Ninth Circuit has affirmatively stated in two published opinions, and one unpublished decision, that California's right of publicity is not preempted by federal copyright law. In *Midler v. Ford Motor Co.*,<sup>132</sup> Bette Midler, a well-known recording artist, sued Ford Motor Company for misappropriating her likeness and infringing on her right of publicity after the car manufacturer used an impersonator of Midler's voice to sing one of her songs in the background of a car commercial. The defendants claimed, among other things, that California's right of publicity was preempted by federal copyright law, but the Ninth Circuit rejected copyright preemption because a voice is not a subject matter of copyright. The court, correctly considering a voice to be something inextricably linked to the intangible proprietary right of one's identity and distinct from what can be protected sufficiently by copyright law, stated, "[a] voice is not copyrightable. The sounds are not 'fixed.' What is put forward as protectible here is more personal than any work of authorship"<sup>133</sup> for "[a] voice is as distinctive and personal as a face."<sup>134</sup>

Thus, since the elements of identity and likeness that are protected by the right of publicity do not fall within the subject matter of federal copyright law, the federal law does not preclude a celebrity from recovering for an infringement on his or her publicity rights. Four years later, in a very similar fact pattern, the Ninth Circuit again held that California's right of publicity was not preempted by federal

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130 *Id.*

131 *Id.*

132 849 F.2d 460 (9th Cir. 1988).

133 *Id.* at 462.

134 *Id.* at 463.

copyright law. In *Waits v. Frito-Lay, Inc.*,<sup>135</sup> singer Tom Waits sued a snack food manufacturer following the broadcast of a radio commercial which featured a vocal performance imitating Waits' "raspy, gravely singing voice."<sup>136</sup>

In defending the use of the impersonator's voice in their advertisements, the defendants argued that federal copyright law preempted California's right of publicity law. The Ninth Circuit Court, holding that the right of publicity was not preempted, stated:

Waits' claim . . . is for infringement of voice, not for infringement of a copyrightable subject such as sound recording or musical composition. Moreover, . . . "[t]he evolving common law rights of 'privacy,' 'publicity,' and trade secrets . . . remain unaffected [by the preemption provision] as long as the causes of action contain elements, such as the invasion of personal rights . . . that are different in kind from copyright infringement." Waits' voice misappropriation claim is one for invasion of a personal property right: his right of publicity to control the use of his identity as embodied in his voice.<sup>137</sup>

The court then elaborated that the focus of both *Waits* and *Midler* was whether the defendants had misappropriated Waits' voice itself and not simply its style and whether Waits' voice was known widely enough to give him a protectible right in its use. The court held, "These elements are 'different in kind' from those in a copyright infringement case challenging the unauthorized use of a song or recording. Waits' voice misappropriation claim, therefore, is not preempted by federal copyright law."<sup>138</sup> Thus, the Ninth Circuit reaffirmed its holding in *Midler* that California's right of publicity is not preempted by federal copyright law.

In an unpublished decision in *Wendt v. Host International*,<sup>139</sup> the Court stated up front that the right of publicity is not preempted. In that case, the defendants implemented animatronic figures of actors George Wendt<sup>140</sup> and John Ratzenberger of the television show

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135 978 F.2d 1093 (9th Cir. 1992).

136 *Id.* at 1097.

137 *Id.* at 1100 (quoting H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748).

138 *Id.* at 1100.

139 No. 93-56318, 93-56510, 1995 U.S. App. LEXIS 5464, 35 U.S.P.Q.2d (BNA) 1315 (9th Cir. Mar. 16, 1995).

140 Although George Wendt is best known to television audiences as the unforgettable Norm Peterson from *Cheers*, his film experience includes *Guilty by Suspicion*, *Fletch*, *Spice World*, *Rupert's Land*, and the recently completed *Outside Providence*, starring Alec Baldwin and Hollywood newcomer Shawn Hatosy.

*Cheers*<sup>141</sup> in airport bars throughout the country. The actors sued for appropriation of their identities in the design of the figures. The *Wendt* decision was not published which is unfortunate because the Court provided a cogent approach and instructive language on the preemption issue:

At the outset we wish to make it clear that this is not a preemption case. Plaintiffs' causes of action are not preempted by federal copyright law. . . . [T]he torts at issue require the proof of additional elements beyond those essential to show copyright infringement. For example, both section 3344 and the common law right of publicity tort require proof that the defendant's use of the plaintiff's 'likeness' or 'identity' was commercial (i.e., connected with selling or promoting a product), whereas copyright infringement occurs with any unauthorized copying of the protected material.<sup>142</sup>

Thus, in accordance with *Waits* and *Midler*, the Ninth Circuit determined that the right of publicity was not preempted. Although the Ninth Circuit appears to establish that federal law does not preempt the right of publicity, California state courts and lower district courts within the Ninth Circuit have found preemption in certain instances. For example, the United States District Court for the Central District of California held that federal copyright law preempted California's right of publicity in *Motown Record Corporation v. George A. Hormel & Co.*<sup>143</sup>

In that case, which predated *Midler* and *Waits*, Jobete Music Company owned the copyright to the musical composition "Baby Love" which was recorded by The Supremes. Although the various recording artists comprising The Supremes changed over the years, the group always consisted of a trio of young black women in formal gowns and bouffant hairstyles. Motown owned the trademark to The Supremes.

The suit arose from a Hormel television commercial for Dinty Moore brand beef stew that featured three young black women with bouffant hair and formal gowns singing, "Dinty Moore, My Dinty Moore," to the tune of "Baby Love." The plaintiffs alleged that the use of the image of The Supremes in the commercial without Motown's permission was likely to cause confusion and create the misimpression that Motown authorized the use of the image of The Supremes.

In holding that federal copyright law preempted plaintiffs' right of publicity claim, the court emphasized, "Without the use of the tune

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141 Produced by Charles Burrows Charles Productions.

142 *Wendt*, 1995 U.S. App. LEXIS 5464, at \*2-\*4.

143 657 F. Supp. 1236 (C.D. Cal. 1987).

from 'Baby Love,' plaintiffs [sic] complaint would most likely be without merit."<sup>144</sup> Therefore, the right of publicity claim in the *Motown* case "revolve[d] around the unauthorized use of a copyrighted work"<sup>145</sup> rather than the theft of an attribute of personal identity. The *Motown* court recognized the limits to which its finding of preemption could be applied by expressly stating:

The Court recognizes that § 3344 may not always be preempted by copyright law. However, given the unique nature of plaintiffs' complaint, the Court finds that the basic act which constitutes the alleged infringement—the unauthorized use of plaintiffs' composition—is the same as that of copyright and is therefore preempted.<sup>146</sup>

Unlike the majority of right of publicity claims, *Motown* was not brought by an individual asserting unauthorized use of his or her persona. Instead, the right of publicity claim was asserted by the corporate owner of the copyright that had been copied by the defendant.<sup>147</sup> Since the plaintiffs owned the copyright in, and were protected by copyright law for, the same composition that formed the basis of their right of publicity claim, allowing recovery under the right of publicity would have granted the plaintiffs rights "equivalent to" those of copyright law. Thus, the facts of *Motown* can be distinguished from most right of publicity claims. Furthermore, *Motown* was decided without the guidance of *Midler* or *Waits*.

The California State Court of Appeals recently found that federal copyright law preempted the plaintiff's right of publicity claim in *Fleet v. CBS, Inc.*<sup>148</sup> In that case, Stephan Fleet and Archie Simpson, both minors, appeared in a movie co-produced by White Dragon Productions of which Fleet's father was one of two sole shareholders. White Dragon entered into a distribution agreement with CBS, granting CBS

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144 *Id.* at 1240.

145 *Id.*

146 *Id.* at 1240–41.

147 A discussion as to whether a corporation should be allowed a right of publicity is beyond the scope of this Note, but I would argue that it does not for several reasons. First, the right of publicity is a personal proprietary right associated with a person's, not a corporate entity's, persona or likeness. The policy considerations and rationales for publicity rights protection do not extend to such protection for corporate entities. Second, the corporate owner will be protected by trademark law for any misappropriations that threaten to confuse the consumer as to the source of the goods or services in question. Finally, the owner of a copyright to a performed work will be protected by federal copyright law for any infringement of that same copyrighted work. In that instance, state protection would be equivalent to, and therefore preempted by, federal copyright law.

148 58 Cal. Rptr. 2d 645, 649 (Ct. App. 1996).

exclusive rights to distribute the motion picture.<sup>149</sup> White Dragon also entered into a separate agreement with Performance Guarantees, Inc. to ensure that the film would be completed on time and on budget.<sup>150</sup>

White Dragon began principal photography for the film in September 1985, but Performance Guarantees stepped in to complete the film in March 1986.<sup>151</sup> The completion guarantor paid neither Fleet nor Simpson for their performances, so the actors informed CBS that they had not been compensated for their performances in the film, and asserted that CBS therefore did not have permission to utilize their names or likenesses in conjunction with exploitation of the film. Nonetheless, CBS released the film on videotape under the title, *Legend of the White Horse*, and included a picture of Stephan Fleet on the box. Fleet and Simpson sued, stating that CBS was not authorized to use performances of Fleet or Simpson because CBS had breached the terms of the distribution agreement by not fully paying the actors, not granting them credit to which they were contractually entitled on videocassette releases of the motion picture, and redubbing all of Fleet's speaking parts without his consent.<sup>152</sup> CBS responded that it owned the copyright pursuant to federal copyright law.<sup>153</sup>

The trial court granted CBS's motion for summary judgment on the ground that the actors' performances were within the subject matter of copyright protection in that they were "fixed in a tangible medium of expression," rendering the "rights asserted . . . equivalent to the exclusive rights of copyright."<sup>154</sup> Fleet and Simpson appealed, and the Court of Appeals agreed with the trial court that federal law preempted the actors' right of publicity claims. The court stated:

We agree that as a general proposition section 3344 is intended to protect rights which cannot be copyrighted and that claims made under its provisions are usually not preempted. But appellants' analysis crumbles in the face of one obvious fact: their individual performances in the film White Dragon were copyrightable. Since their section 3344 claims seek only to prevent CBS from reproducing and distributing their performances in the film, their claims must be preempted by federal copyright law.<sup>155</sup>

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149 *Id.* at 646.

150 *Id.* at 647.

151 *Id.*

152 *Id.*

153 *Id.* at 648.

154 *Id.*

155 *Id.* at 650.

The court determined that the right of publicity claims of the young actors were "within the subject matter of copyright" since, "[t]here can be no question that, once appellants' performances were put on film, they became 'dramatic works' 'fixed in [a] tangible medium of expression'."<sup>156</sup> The problem with this statement is that many questions may arise as to whether the actors' claims fell within the subject matter of copyright. The actors did not claim that they owned an interest in the copyright of the films. Rather, they sought to prevent their names, likenesses, and identities from being used in the distribution and promotion of films in which they appeared but with whom the distributor apparently had breached contractual duties. Just because the actors were captured on film did not render their identities and personas fixed in a tangible form.

Assume Mel Gibson's friends throw him a birthday party, and one of Gibson's acquaintances takes pictures of the actor. Gibson knows he is being photographed and allows his friend to photograph him. Gibson's friend now has photographs of the actor to which the actor has consented. Furthermore, the friend, as the photographer, owns the copyright to those photographs. Under the rationale of the *Fleet* court, Gibson's friend could now sell T-shirts with Gibson's photograph on it, or make posters of the photograph and distribute them for the friend's personal gain simply because Gibson's identity has been reduced to a tangible form and is protected by the copyright of the photographer.

The *Fleet* court attempted to reconcile its decision with *Zacchini*<sup>157</sup> by highlighting that the "important distinction" between *Fleet* and *Zacchini* was that *Zacchini* had not consented to the taping of the cannonball act. Two major flaws manifest themselves in this argument. First, even if *Fleet* initially permitted the filming of his acting, any contractual breach of duties owed by CBS to *Fleet* renders the broken contract the equivalent of *Fleet* not consenting to the reduction of his likeness to a copyrightable, tangible form. Second, even if an actor consents to the filming, photographing, drawing or any other reduction of his performance to a tangible form, this does not provide blanket consent for the "author" of the reduced "writing" to exploit the actor's identity however he sees fit. Such a misinterpretation of the law would lead to a situation akin to the Mel Gibson birthday photo hypothetical. Other commentators have stated the same.<sup>158</sup>

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156 *Id.*

157 *Zacchini v. Scripps-Howard Broad. Co.*, 433 U.S. 562 (1977).

158 *See, e.g.*, 1 NIMMER & NIMMER, *supra* note 88, § 1.01[b][1][c], at 1-22 to -23.

The *Fleet* court justified its opinion that Fleet's right of publicity claim was the equivalent of copyright based on CBS's proposed use of the film.<sup>159</sup> The court stated, "CBS seeks to display or reproduce those images and no others. The owner of a copyright—either the 'author' (actor) or his employer (the producer)—is vested with the exclusive rights to, among other things, 'reproduce the copyrighted work' and 'display the copyrighted work publicly.'"<sup>160</sup>

This argument, specious for the same reasons as the Mel Gibson birthday photograph hypothetical, ignores the fact that a copyright owner has exclusive rights under federal copyright law only if the proposed state rights are equivalent to the rights afforded by federal copyright laws. The publicity rights that adhere to a person's persona are not tangible, and simply taking a picture or filming a person in an act does not grant the photographer exclusive rights to the use of the work if that use infringes on the publicity rights of the celebrity; rights which require proving elements in addition to, and apart from, those required of copyright infringement.

Similarly, unauthorized photographs might be copyrightable, but the person photographed might object to distribution under the right of privacy. The *Fleet* court attempts to rectify its decision with scenarios similar to the Mel Gibson hypothetical by claiming, "[a]n actor who wishes to protect the use of the image contained in a single, fixed dramatic performance need simply retain the copyright."<sup>161</sup> This statement presents an egregious example of injustice and epitomizes the reason that artists deserve to have their interests protected from those who wish to exploit their identities for commercial gain. Only a handful of actors can afford to purchase the copyrights to their works<sup>162</sup> or to actually produce their current projects,<sup>163</sup> and even

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159 *Fleet*, 58 Cal. Rptr. 2d at 650.

160 *Id.*

161 *Id.* at 651.

162 Telephone Interview with Vicki Shapiro, Attorney for Screen Actors Guild (Mar. 28, 1997).

163 Only the most established actors have their own production companies with studio deals. A few of them are: Alec Baldwin (*El Dorado*), Nicholas Cage (*Saturn*), Sean Connery (*Fountainbridge*), Tom Cruise (*C/W*), Billy Crystal (*Face*), Robert De Niro (*Tribeca*), Danny DeVito (*Jersey*), Michael Douglas (*Douglas/Reuther*), Jodie Foster (*Egg*), Mel Gibson (*Icon*), Diane Keaton (*Blue Relief*), Michael Keaton (*Colombo/Keaton*), Harvey Keitel (*Goatsingers*), Martin Lawrence (*You Go Boy*), Madonna (*Maverick*), Bette Midler (*All Girls*), Eddie Murphy (*Eddie Murphy*), Michelle Pfeiffer (*Via Rosa*), Bill Pullman (*Big Town*), Tim Robbins (*Havoc*), Daniel Stern (*Chesapeake*), Alicia Silverstone (*First Kiss*), Michael Stipe (*Single Cell*), Barbra Streisand (*Barwood*), Quentin Tarantino (*A Band Apart*), Robin Williams (*Blue Wolf*), Bruce Willis (*Flying Heart*). 29 HOLLYWOOD CREATIVE DIRECTORY (Feb. 1996).

though they may be so fortunate now, chances are they were not earlier in their careers.<sup>164</sup>

For example, Mel Gibson might be able to afford an interest in his current projects,<sup>165</sup> yet he certainly could not have afforded the copyright to earlier acting forays like *Mad Max*.<sup>166</sup> Unlike well-paid attorneys or judges, the struggling actor can hardly afford the gas to get to his audition, much less the money to purchase a copyright in his performance. It is no more reasonable to assume that an actor can purchase the copyright to his performance than it is to assume that a young model can afford to purchase the diamond tiara that graces her neck for a one-day photo shoot. To reason that they could would result in virtually no actor having publicity rights protection for his or her identity as personified early in the artist's career.

The *Fleet* court then relied on the Seventh Circuit Court's decision in *Baltimore Orioles v. Major League Baseball Players Association*<sup>167</sup> and even cited the Seventh Circuit's reasoning, "[b]y virtue of being videotaped . . . the Players' performances are fixed in tangible form, and any rights of publicity in their performances that are equivalent to the rights contained in the copyright of the telecast are preempted."<sup>168</sup> This statement is correct, but incorrectly applied.

True, if the rights of publicity are equivalent to the rights afforded by copyright, those rights will be preempted. Of importance in the instance of right of publicity, however, is that the right of publicity, even if reduced to a tangible form, is not equivalent to copyright since it requires proving the additional elements of the plaintiff's recognizable identity or use for the defendant's commercial advantage.

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Although these artists are currently established enough to purchase a proprietary interest in some of their projects, they certainly were not so fortunate early in their careers. For example, Brad Pitt is currently an internationally recognizable name while James Marsden, the star of MGM's *Disturbing Behavior*, is relatively unknown. Nonetheless, in just a few years time, the pecuniary value of Marsden's identity could very well eclipse that of Pitt's.

164 Just because Tom Cruise's C/W Productions could afford to produce *Mission Impossible* in 1996 does not mean that Cruise could have purchased the copyright to *Risky Business* in 1983, yet that is precisely the position championed by the *Fleet* court and others espousing the viewpoint of "just have the talent buy the copyright." This reasoning would result in almost no artist having a publicity right in his or her identity as personified early in the performer's career.

165 Mel Gibson's Icon Productions produced his Academy Award winning film *Braveheart*. BRAVEHEART (Paramount Pictures 1995).

166 MAD MAX (Crossroads International Finance 1979).

167 805 F.2d 663 (7th Cir. 1986); see *infra* Part V(C).

168 *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 652 (Ct. App. 1996) (citing *Orioles*, 805 F.2d at 675).



Rulings such as *Fleet* which find that the right of publicity is preempted constitute a dangerous precedent. On the other hand, the facts of *Fleet* potentially address only the scenario of actual reproduction, performance, and display of the film according to CBS's distribution agreement. If CBS did not violate terms of contracts with Fleet, the court is correct in holding that when the artist consents to a particular use of his identity in a copyrightable form, the resulting holder of that copyright cannot be deterred from exercising the exclusive rights of his copyright by any state law such as the right of publicity. The briefs of both parties in the *Astaire*<sup>169</sup> case discussed *Fleet*, so the decision of the Ninth Circuit in this case could have at once discussed *Fleet*'s limitations, limited *Motown* to its facts, and provided a concrete approach of the Ninth Circuit on the preemption issue.

### C. Courts Outside California and the Ninth Circuit

The Second Circuit Court of Appeals likewise held that federal copyright law did not preempt state right of publicity laws in *Factors, Etc., Inc. v. Pro Arts, Inc.*<sup>170</sup> The issue before the court was whether Elvis Presley's right of publicity was devisable. In that case, Elvis Presley had established Boxcar Enterprises, Inc., a Tennessee corporation, and assigned to it exclusive ownership of all rights to his name and likeness for commercial purposes.<sup>171</sup> Two days after Presley's death, Boxcar granted an exclusive license to use Presley's name and likeness to Factors, Etc., a Delaware corporation, and the next day, Pro Arts, Inc., an Ohio corporation, published a poster of Presley. Pro Arts had purchased the copyright in the photograph from a newspaper photographer who had taken it.

The Second Circuit Court reversed the lower court ruling on other grounds,<sup>172</sup> so the majority opinion expressly refused to address

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169 *Astaire v. Best Film & Video Corp.*, 116 F.3d 1297 (9th Cir. 1997).

170 652 F.2d 278 (2d Cir. 1981).

171 *Id.*

172 In the first part of the litigation, the Second Circuit Court affirmed Factors' injunction against Pro Arts. Nonetheless, contemporaneously with the initiation of the suit against Factors, the Memphis Development Corporation sued Factors in the Western District of Tennessee to prevent Factors from interfering with the foundation's fundraising efforts by which they used pewter replicas of the proposed Presley statue. The Sixth Circuit held that Presley's right of publicity did not survive his death. Then, when Factors moved for summary judgment in the New York litigation against Pro Arts, Pro Arts brought the Sixth Circuit's ruling to the attention of the District Court and asserted that the holding estopped Factors from claiming it had any exclusive publicity rights to the name and likeness of Presley after his death. The Second Circuit Court deferred to the views of the Sixth Circuit and concluded that

the issue of preemption.<sup>173</sup> Nonetheless, Judge Mansfield's dissent addressed the issue. He agreed with the exhaustive discussion and conclusion of Judge Tenney<sup>174</sup> of the district court

that the right protected here is not equivalent to any within the general scope of federal copyright law and so is not preempted by the 1909 Act, as interpreted in *Goldstein* . . . . It would likewise not have been preempted under § 301 of the new 1976 Act . . . if the events had occurred after 1978.<sup>175</sup>

Judge Mansfield continued:

The right of publicity protects an interest which copyright does not. That interest is the individual's ability commercially to maintain and exploit his fame and persona. Copyright merely protects the holder from the taking of specific expressions or arrangements he or she had created. The right of publicity, on the other hand, protects against the unauthorized appropriation of an individual's very persona which would result in unearned commercial gain to another. If this right is not the equivalent of a copyright interest . . . (as Pro Arts concedes) it is equally not the equivalent after he has died and it has been devised. Other courts which have considered the preemption argument in this exact context have reached the same conclusion as that arrived at by the district court here.<sup>176</sup>

Thus, although the majority opinion of the Second Circuit did not address the preemption issue, Justice Mansfield's dissent and reference to the district court's elaborate discussion of the issue indicated that congressional action had not preempted the recognition of the common law right of publicity.

The Federal District Court for the Southern District of New York held that federal copyright law did not preempt the right of publicity in *Bi-Rite Enterprises v. Button Master*.<sup>177</sup> In that case, the manufacturer

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after Presley's death, Boxcar had no right of publicity in Presley's name and likeness to convey to Factors. See *id.* at 283.

173 See *id.* at 283 n.8 ("In view of our disposition of the appeal . . . we need not consider Pro Arts' other contentions, which include . . . [whether] federal copyright law preempts application of state law purporting to protect such a right [of publicity].").

174 *Id.* at 289 (Mansfield, J., dissenting) (citing *Factors Etc., Inc v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1095-1100 (S.D.N.Y. 1980), *rev'd*, 652 F.2d 278 (2d Cir. 1981). Judge Tenney's opinion includes an in depth discussion of potential preemption and concludes that the 1976 Act was not intended to preempt the right of publicity.

175 See *Factors, Etc.*, 652 F.2d at 289 (Mansfield, J., dissenting).

176 *Id.* (citing *Lugosi v. Universal Pictures*, 603 P.2d 425, 448 (Cal. 1979) (Bird, C.J., dissenting) and *Apigram Publ'g Co. v. Factors Etc., Inc.*, Civ. No. C78-525, 1980 U.S. Dist. LEXIS 9738 (N.D. Ohio July 30, 1980).

177 555 F. Supp. 1188 (S.D.N.Y. 1983).

and distributor of posters, buttons, patches, and novelty items joined several performers<sup>178</sup> in suing defendants who were selling unlicensed buttons bearing the logos and likenesses of the plaintiffs. The district court applied the law of the states in which the individual plaintiffs or their exclusive licensees resided,<sup>179</sup> so California, Illinois, and Georgia right of publicity laws were applied to the plaintiffs' claims, depending on their states of residence.<sup>180</sup>

The court recognized that the right of publicity existed in all three states,<sup>181</sup> defined the right of publicity generally to grant a person an exclusive right to control the commercial value of his name and likeness and to prevent others from exploiting that value without permission,<sup>182</sup> and concluded that federal copyright law did not preempt the plaintiffs' right of publicity claims. In holding that the right of publicity was not preempted, the court stated:

The right of publicity therefore grants plaintiffs relief where none exists under federal law. Federal preemption poses no bar to such relief. "The intangible proprietary interest protected by the right of publicity simply does not constitute a writing," . . . and therefore falls outside of the preemption standards established by Congress in the copyright law . . . .<sup>183</sup>

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178 *Id.* at 1191 ("The plaintiffs also include several rock groups—Judas Priest, Molly Hatchett, Devo, Styx, and Iron Maiden—their individual members, and two solo performers, Neil Young, and Pat Benatar.").

179 *Id.* at 1197 (citing *Groucho Marx Prods. v. Day & Night Co.*, 689 F.2d 317, 319 (2d Cir. 1982) ("A New York court, considering a right of publicity case, would apply its property choice-of-law rules to select the state whose law determines whether a plaintiff has a protectible right of publicity.")).

180 *Id.* ("Plaintiffs Pat Benatar, Neil Young and members of the group Devo, plus their managers or licensees all reside in California . . . . Accordingly the situs of these plaintiffs' proprietary publicity interest is California . . . . Bi-Rite, an Illinois corporation with its principal place of business in Illinois, is also subject to Illinois Law.").

181 *Id.* at 1198 (citing *Winterland Concessions Co. v. Sileo*, 528 F. Supp. 1201, 1213–14 (N.D. Ill. 1982); *Martin Luther King, Jr., Ctr. for Soc. Change, Inc. v. American Heritage Prods., Inc.*, 508 F. Supp. 854 (N.D. Ga. 1981), *rev'd on other grounds*, 694 F.2d 674 (11th Cir. 1983); *Lugosi v. Universal Pictures*, 603 P.2d 425 (Cal. 1979); *McQueen v. Wilson*, 161 S.E.2d 63, 66 (Ga. Ct. App.), *rev'd on other grounds*, 162 S.E.2d 313 (Ga. 1968); *National Football League Properties, Inc. v. Consumer Enters., Inc.*, 327 N.E.2d 242, 245 (Ill. App. Ct. 1975)).

182 *Id.* (citing *Martin Luther King Jr., Center for Soc. Change, Inc.*, 508 F. Supp. at 862; *Haelan Laboratories, Inc. v. Topps Chewing Gum, Inc.*, 202 F.2d 866, 868 (2d Cir. 1953); *Lugosi*, 603 P.2d at 431 (Bird, C.J., dissenting)).

183 *Bi-Rite*, 555 F. Supp. at 1201 (quoting *Lugosi*, 603 P.2d at 448 (Bird, C.J., dissenting) and citing 17 U.S.C. § 301 (1994); *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1097 (S.D.N.Y. 1980); *Price v. Hal Roach Studios, Inc.*, 400 F. Supp. 836, 842–46 (S.D.N.Y. 1975)).

Thus, as *Factors* and *Bi-Rite* indicate, Second Circuit courts share the opinion of the Ninth Circuit that federal copyright law does not preempt a state's right of publicity law. Despite the established holdings of the United States Supreme Court and several circuit and state courts, the Seventh Circuit Court of Appeals has held that federal copyright law preempts the right of publicity.<sup>184</sup> That court's conclusions were influenced by the fact that many aspects of what makes a person a public figure can be captured in media such as film or tape which are eligible for copyright protection. Since an individual's persona may be "fixed in any tangible means of expression,"<sup>185</sup> the right of publicity protecting these copyrightable interests is preempted by federal copyright.<sup>186</sup>

The reasoning that part of a persona may be captured in copyrightable media was relied upon in *Baltimore Orioles v. Major League Baseball Players Association*<sup>187</sup> in which professional baseball players sued major league franchises for using their identities to promote the franchise by broadcasting current games. Although the clubs owned the copyright to the telecasts of the games, the players claimed that broadcasts of the games made without their express consent violated their rights of publicity in their performances.<sup>188</sup> The Seventh Circuit held that the clubs' copyright in the telecasts of major league games preempted the players' rights of publicity.<sup>189</sup> The court also held that a baseball game was a protectible work of authorship.<sup>190</sup>

This erroneous conclusion has received a lot of criticism<sup>191</sup> since sporting events are not original works of authorship under

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184 See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663 (7th Cir. 1986).

185 17 U.S.C. § 102(a) (1994).

186 See *Orioles*, 805 F.2d at 677 (finding that baseball players' personae "are fixed in tangible form and come within the subject of copyright"); see generally Shipley, *supra* note 13, at 701-23 (stating that to provide for the continuing vitality of the publicity doctrine, courts must construe state law publicity rights in the context of the current federal copyright law).

187 *Orioles*, 805 F.2d at 669 n.7.

188 *Id.*

189 *Id.*

190 *Id.* (stating that players' performances contain the modest creativity required for copyrightability).

191 See 1 NIMMER & NIMMER, *supra* note 88, § 2.09[F] at 2-170 ("[A]thletic events are subject to legal protection pursuant only to right of publicity, misappropriation, and other established legal doctrines outside the ambit of statutory copyright."); see also *Fleet v. CBS*, 58 Cal. Rptr. 2d 645, 652 (Ct. App. 1996) ("The Seventh Circuit decided that a baseball game or other sporting event was a creative work of authorship. We can well understand why that conclusion has given rise to much controversy among the commentators and express no opinion as to its correctness.").

§ 102.<sup>192</sup> Although there may be an underlying coach's book or game plan, sporting events are not "authored" since there is no underlying script or other expression reduceable to a tangible form.<sup>193</sup> Therefore, sporting events do not fall within the subject matter of copyright and are not copyrightable.<sup>194</sup> On the other hand, broadcasts of sporting events, as opposed to the events themselves, are entitled to copyright protection.<sup>195</sup>

The court continued by stating that once a performance is reduced to a tangible form by being taped, no distinction exists between the performance and the recording of the performance for the purposes of preemption.<sup>196</sup>

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192 § 102 lists the eight categories of authorship as follows:

(a) Copyright protection subsists, in accordance with this title, in original works of authorship fixed in any tangible medium of expression, now known or later developed, from which they can be perceived, reproduced, or otherwise communicated, either directly or with the aid of a machine or device. Works of authorship include the following categories:

- (1) literary works;
- (2) musical works, including any accompanying words;
- (3) dramatic works, including any accompanying music;
- (4) pantomimes and choreographic works;
- (5) pictorial, graphic, and sculptural works;
- (6) motion pictures and other audiovisual works;
- (7) sound recordings; and
- (8) architectural works.

17 U.S.C. § 102(a) (1994).

193 See *National Basketball Ass'n v. Motorola* 105 F.3d 841, 846 (2d Cir. 1997) ("Sports events are not 'authored' in any common sense of the word. There is, of course . . . considerable preparation for a game. However, the preparation is as much an expression of hope or faith as a determination of what will actually happen. Unlike movies, plays, television programs, or operas, athletic events are competitive and have no underlying script.").

194 See *1 NIMMER & NIMMER*, *supra* note 88, § 2.09[F] at 2-170 (stating that the "far more reasonable" position is that athletic events are not copyrightable).

195 See 17 U.S.C. § 101 (1994) ("A work consisting of sounds, images, or both, that are being transmitted, is 'fixed' for purposes of this title if a fixation of the work is being made simultaneously with its transmission."); see also H.R. REP. NO. 94-1476, at 52 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5665 ("When a football game is being covered by four television cameras, with a director guiding the activity of the four cameramen and choosing which of their electronic images are sent out to the public and in what order, there is little doubt that what the cameramen and the director are doing constitutes 'authorship.'").

196 The court stated that the telecasts were fixed in a tangible form because they were recorded simultaneously with their transmission and were audiovisual works which come within the subject matter of copyright. The major flaw in this reasoning stems from the fact that the works in which the Players' rights of publicity subsist are

Thus, if a baseball game were not broadcast or were telecast without being recorded, the players' performances similarly would not be fixed in a tangible form and their rights of publicity would not be subject to preemption. By virtue of being videotaped, however, the players' performances are fixed in a tangible form, and any rights of publicity in their performances that are equivalent to the rights contained in the copyright of the telecast are preempted.<sup>197</sup> It is true that the telecasts were fixed in a tangible form, but the players' personas were not.

Holding that one sacrifices publicity rights in his persona simply because his image was fixed in tangible medium threatens the right of publicity of celebrities who, by the very nature of their work, are almost always captured on film, tape, or some other medium. An individual's likeness and persona are intangible property rights, distinct from those rights protected by the copyright of a tangible work. The court's definition of equivalence involved evaluating the interests protected by the right of publicity and the copyright statute, as well as the elements of the causes of action.<sup>198</sup>

The court declared that the purposes of the right of publicity and copyright were similar, namely to benefit the public by inducing individuals to undertake the personal sacrifices necessary to create works and promote performances of interest to the public.<sup>199</sup>

Although motivating individuals to create original works is a similarity between the policies of copyright and publicity rights, protection provided by the right of publicity protects the intangible personas of individuals and often extends beyond what copyright protection can offer.<sup>200</sup> The purpose of copyright is to allow the individual creator a temporary monopoly over the subject matter of his or her tangible creation while the right of publicity, on the other hand, exceeds that by granting the creative individual an ownership interest in his or her intangible name, likeness, or identity. Thus, the goals and purposes are indeed similar, but they are not equivalent. The *Orioles* court sum-

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the actual performances of the game, and those performances per se are not fixed in a tangible form. See, e.g., Saxer, *supra* note 16.

197 See *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 675 (1987).

198 *Id.* The court then stated that a state "right is equivalent to copyright if (1) it is infringed by the mere act of reproduction, performance, distribution, or display or (2) it requires additional elements to make out the cause of action, but the additional elements do not differ in kind from those necessary for copyright . . ." *Id.* at 678 n.26.

199 *Id.* at 678-79.

200 See *Fleet v. CBS, Inc.*, 58 Cal. Rptr. 2d 645, 650 (Ct. App. 1996) (stating that the right of publicity is "intended to protect rights which cannot be copyrighted").

marily dismissed the guidance of *Zacchini*, *Bi-Rite*, Bird's dissent in *Lugosi*, and Mansfield's dissent in *Factors* by stating:

Each opinion is premised upon an erroneous analysis of preemption . . . [since they] assert without discussion that the right of publicity is not preempted because the work that it protects—a public figure's persona—cannot be fixed in a tangible medium of expression. We disagree. Because a performance is fixed in a tangible form when it is recorded, a right of publicity in a performance that has been reduced to a tangible form is subject to preemption.<sup>201</sup>

This reasoning is subject to the same limitations as those discussed above<sup>202</sup> in response to *Fleet*, which cites *Orioles*.<sup>203</sup> Under this view of the law, the right of publicity could never be asserted based on a defendant's unauthorized use of a celebrity's persona as originally portrayed in a film or other copyrightable work, no matter how commercial the use. A defendant would be free to use film and tape clips or photographs of famous actors or actresses to produce advertisements for consumer goods, to adorn T-shirts and coffee mugs, or for any other concededly commercial purpose, merely because the medium in which the likeness originally appeared was itself the subject of copyright.

It might be argued that the poor decision of the Seventh Circuit can be limited to a factual situation where:

1. The performers are employees of the franchise;
2. The participation in the televised games were within the scope of the performer's employment and therefore were works for hire under 17 U.S.C. § 201(b); and
3. The copyrights were owned by the respective franchises.<sup>204</sup>

Unfortunately, the expansive reach of the *Orioles* decision has influenced not only subsequent Seventh Circuit decisions<sup>205</sup> in which it was mandatory, but a California State Court of Appeal<sup>206</sup> and possibly an Eighth Circuit decision as well.<sup>207</sup>

In the unpublished decision of *Brode v. Tax Management, Inc.*,<sup>208</sup> the plaintiff contended that by using his name in connection with a portfolio he authored that was distributed through the LEXIS

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201 *Orioles*, 805 F.2d at 678 n.26.

202 See *infra* Part IV(C) of this Note.

203 See *Fleet*, 58 Cal. Rptr. 2d at 652.

204 Elliott, *supra* note 35, at 605.

205 See *Brode v. Tax Management, Inc.* 1990 U.S. Dist. LEXIS 998 (N.D. Ill. Jan. 31, 1990).

206 See *Fleet*, 58 Cal. Rptr. 2d at 645.

207 See *Ventura v. Titan Sports*, 65 F.3d 725 (8th Cir. 1995).

208 1990 U.S. Dist. LEXIS 998 (N.D. Ill. Jan. 31, 1990).

database, defendants commercially exploited his name and thereby violated his right of publicity. The district court held that the publicity claim was preempted by federal copyright statute.<sup>209</sup> The court dismissed *Zacchini*, *Bi-Rite*, Bird's dissent in *Lugosi*, and Mansfield's dissent in *Factors*, and quoted the *Orioles* court for the presumption that "[b]ecause the right of publicity does not require a qualitatively different additional element, it is equivalent to a copyright and is preempted to the extent that it is claimed in a tangible work within the subject matter of copyright."<sup>210</sup> The court then concluded that the "plaintiff cannot point to an element in the right of publicity claim which is qualitatively different from the copyright infringement."<sup>211</sup>

As applied to this scenario where the plaintiff was both the copyright owner and the performer, that statement might hold true since the plaintiff could exercise his copyright to remedy himself for unauthorized use.<sup>212</sup> *Brode* was an unpublished decision and involved a plaintiff who held both the copyright in the work and rights in his publicity. Therefore, its influence is limited, but of note is the sweeping adoption of the *Orioles* court's reasoning and the dismissal or absence of other preemption evaluations.

The *Orioles* holding of copyright preemption was mentioned in a recent district court decision within the Seventh Circuit in *Pesina v. Midway Manufacturers Co.*<sup>213</sup> *Pesina*, a martial arts expert, had his movements videotaped, captured by a computer, extensively edited, and incorporated in the defendant's video games of *Mortal Kombat*, *Mortal Kombat II*, and related products as the fictional character of Johnny Cage.<sup>214</sup> Although the plaintiff's identity was severely altered by the time it got to the screen of the video games,<sup>215</sup> he sued for the unconsented use of his name, persona, and likeness in the home version of the video games.

The court found that the defendants did not violate *Pesina's* right of publicity since he could not prove two elements under Illinois right

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209 *Id.* at \*21.

210 *Id.* at \*27 (quoting *Baltimore Orioles, Inc. v. Major League Baseball Players Ass'n*, 805 F.2d 663, 674 (1987)).

211 *Id.*

212 It is possible to have equivalent rights and elements in this situation, with the possible exception that the right of publicity requires showing infringement for the commercial advantage of the defendant, and that the plaintiff might enjoy more extensive remedies under right of publicity laws.

213 948 F. Supp. 40 (N.D. Ill. 1996).

214 *Id.* at 42.

215 *Id.* at 42 ("[A]fter comparing Mr. *Pesina* and the game character, Johnny Cage, who allegedly resembles the plaintiff, only 6% of 306 *Mortal Kombat* users identified Mr. *Pesina* as the model.").



of publicity law: (1) his identity had a commercial value and (2) his likeness was recognizable in the unauthorized use. The particular holding in this case is not nearly as important as the footnote in which the court addresses preemption and limits the application of *Orioles* to a specific set of facts. The court responded to *Orioles* by stating, "[t]his Circuit has suggested that if an employee has contractually limited the media in which his performance may be shown by the employer, should the employer exceed this authority, the employee's right of publicity claim is not preempted."<sup>216</sup> Thus, although mentioned only in passing in a footnote, courts within the Seventh Circuit are at least willing to entertain limiting the *Orioles* holding to instances involving employer/employee relationships.

Despite this potential modification of *Orioles* within the Seventh Circuit, the *Orioles* decision resulted in misguided dicta contained in a footnote of an Eighth Circuit decision in *Ventura v. Titan Sports, Inc.*<sup>217</sup> Professional wrestler and entertainer Jesse "The Body" Ventura claimed that Titan Sports, which operates "The World Wrestling Federation" (WWF) for whom Ventura commentates, infringed on Ventura's right of publicity by using his likeness, beyond what he claimed he had contractually agreed, on videotapes produced by Titan Sports.<sup>218</sup>

The court held that although Minnesota does not recognize the four-fold tort of invasion of privacy, "the Minnesota Supreme Court would recognize the tort of violation of publicity rights."<sup>219</sup> The Eighth Circuit then upheld the district court's holding in favor of Ventura for the exploitation of his commentating performances.

Of importance to this decision is not so much the holding of the court, but rather a footnoted discussion of preemption where the Eighth Circuit cited only *Orioles*. In a footnote the court states, "[w]e are troubled by the fact that section 301(a) of the copyright code (Title 17) preempts Ventura's claims that are 'equivalent to any of the exclusive rights within the general scope of copyright as specified by section 106,' such as the production of videotapes of Ventura's televised commentary."<sup>220</sup> Although reproduction and display are rights under § 106(1) and (5) respectively, and unauthorized reproduction or display would infringe upon the owner's copyright, Ventura did not own the copyright to the work, so copyright law would not provide

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216 *Id.* at 42 n.3 (citing *Baltimore Orioles v. Major League Baseball Players Ass'n*, 805 F.2d 663, 679 n.29 (7th Cir. 1986)).

217 65 F.3d 725 (8th Cir. 1995).

218 *Id.* at 728, 730.

219 *Id.* at 730.

220 *Id.* at 730 n.6 (citing *Orioles*, 805 F.2d at 675).

Ventura with relief. Furthermore, since the right of publicity would require Ventura to prove extra elements such as injury to his intangible persona, the state right would not be equivalent to federal copyright law.

The court cited *Orioles* for the presumption of preemption but ruled that since Titan Sports failed to timely raise the preemption defense on appeal, the preemption issue became moot.<sup>221</sup> The fact that preemption was not an issue, coupled with the cursory treatment in which the court needed only to address the issue in dicta in a footnote, suggests that a more elaborate discussion of the issue by the Eighth Circuit could hold that federal copyright law does not preempt the right of publicity. Nonetheless, the manner in which the court cited only the *Orioles* holding of preemption, to the noticeable exclusion of Ninth Circuit, Second Circuit, and United States Supreme Court decisions, is of note.

#### D. *Application to Facts of Astaire v. Best Film & Video*

In *Astaire v. Best Film & Video*,<sup>222</sup> which was recently decided by the Ninth Circuit on issues other than federal preemption, the widow of Fred Astaire sought to enjoin a video production company from violating her husband's right of publicity.<sup>223</sup> The defendant, Best Film & Video, argued, among other things, that Astaire's right of publicity claim was preempted by federal copyright law.<sup>224</sup> Best based its preemption argument on a broad reading of *Sears* and *Compco*, without citing *Goldstein's* or *Waits'* language limiting the *Sears* and *Compco* line of cases.<sup>225</sup>

Because the films from which the clips were taken were the proper subject of copyright<sup>226</sup> and had fallen into the public domain, Best erroneously concluded, "so long as that use involved only dupli-

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221 The Eighth Circuit's dismissal of the preemption defenses begs the question of whether federal preemption is an affirmative defense or indeed able to be waived.

222 116 F.3d 1297 (9th Cir. 1997).

223 Robyn Astaire also holds the right to Fred Astaire's name, voice, photograph, and likeness under CAL. CIV. CODE § 990 (West 1998).

224 Facts of *Astaire* are detailed in *supra* Part II(B) of this Note.

225 *Sears* and *Compco* are discussed in *supra* Part II(B) of this Note. See 4 NIMMER & NIMMER, *supra* note 88, §16.04[C], at 16-29 (1997) ("[T]he Supreme Court in *Goldstein v. California*, held that *Sears-Compco* justifies federal preemption only in the patent, not in the copyright sphere.") (citations omitted); see also *Waits v. Frito-Lay, Inc.*, 978 F.2d 1093, 1099 (9th Cir. 1992) (rejecting assertion that the Supreme Court has "endorse[d] or resurrect[ed] the broad reading of *Compco* and *Sears* urged by defendants").

226 See 17 U.S.C. § 102(a) (1994).

cation and incorporation into another work, no one but the copyright holder would have the right to authorize or refuse to authorize such a use."<sup>227</sup>

The problem with this statement is that the right of the copyright holder refers to the owner's right in the tangibly reduced expression. It does not mean that the copyright holder can then use the work in a manner infringing on the celebrity's publicity rights which protect the intangible persona of the individual.

For example, if a producer owns the copyright to four episodes of *In Living Color*,<sup>228</sup> that does not mean that he can incorporate an hour of Jim Carrey's performances into another work, such as a commercial for vacuum cleaners. Put another way, the producer needs the performer's permission to make such a use of his identity, regardless of whether the producer or anybody else owns the copyright to the performance. It also does not mean that the producer can make a "How to Make People Laugh" video and then, in attempting to sell the cassettes to distributors, insert a minute and a half of Jim Carrey's rubber-faced comedy routines into the cassettes without Carrey's permission. Granting exclusive rights to the copyright holder at the expense of the celebrity would allow any producer or distributor to simply edit and mix his film stock of a certain celebrity and incorporate that celebrity's identity and image into the producer's future works, regardless of whether the celebrity consents.

In responding to defendant's reasoning on this issue, the district court correctly concluded that California's right of publicity prohibits the use of film excerpts that include the image and likeness of a celebrity who has not consented to such a use. Best responded that this holding places California's right of publicity law

on a collision course with the Copyright Act. If it is entirely lawful to duplicate public domain film clips of Fred Astaire and incorporate them into another work under federal copyright law (which it is), state law cannot render the same duplication and use a misappropriation unless consent is obtained.<sup>229</sup>

Best erroneously maintained, "Since any copy or derivative of copy-rightable material that includes a celebrity likeness will necessarily involve the use of the likeness on a product, such a claim, where the

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227 Appellant's Opening Brief at 22, *Astaire* (No. 95-56632).

228 Produced by Ivory Way Productions. This television variety program was originally aired on Fox. It featured the abilities of many now-famous artists, including Jim Carrey, Damon Wayans, Jennifer Lopez, and many other talented individuals.

229 Appellant's Opening Brief at 23, *Astaire* (No. 95-56632).

likeness used is the subject of copyright, is tantamount to a claim of copying, and is therefore preempted."<sup>230</sup>

This argument fails because it would yield the devastating result that celebrities would sacrifice their publicity rights in anything to which another, or the public, owns the copyright. This would completely eliminate the rights actors have in their hard-earned personas and images since the producer or distributor who owns the copyright could use the work in any manner he or she desires, regardless of how it impacts the celebrity's likeness. Best attempted to distinguish *Waits* and *Midler* as controlling only where there is a false endorsement.<sup>231</sup> Best argued:

Were the Court to allow the right of publicity to be expanded as Astaire suggests, the preemption doctrine itself would be swallowed whole so long as the materials subject to copyright contain any identifiable individual. Under the lower court's ruling, if an individual is depicted in a work subject to copyright, then a publicity rights claim would lie, regardless of who owns the copyright or if the work has fallen under the public domain, and no matter what context the use occurs. In effect, the rule would grant the individual depicted or his estate possess [sic] a compulsory license right on the use of the material subject to copyright and the concomitant ability to prevent its reproduction entirely. Any time that film clips (whether copyrighted or public domain) are used in any context, there would be the potential for a publicity rights claim from any individual depicted in those film clips . . . . If the Court adopts the ruling Astaire urges, and allows publicity rights claims even in the absence of a false endorsement found in *Waits* and *Midler* and the other cases Astaire cites, celebrities will in effect step into the shoes of the copyright holder, being able to control when and where film clips can be reproduced. A clearer collision course with the exclusive provisions of the Copyright Act cannot be envisioned.<sup>232</sup>

This specious argument fails to recognize that the correct focus is not whether Best's use constitutes a "false endorsement," but whether the right of publicity in Fred Astaire's likeness falls within the subject matter of copyright. Like the voices in *Midler* and *Waits*, the likeness of Fred Astaire is intangible. Even though a likeness and voice can be embodied in a tangible work, it is the personal attribute itself, not the tangible embodiment of it, that is protected by the right of publicity.

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230 *Id.* at 26 (citing *Sinatra v. Goodyear Tire & Rubber Co.*, 435 F.2d 711, 717 (9th Cir. 1970) and *Sammons & Sons v. Ladd-Fab, Inc.*, 187 Cal. Rptr. 874, 877 (Ct. App. 1982)).

231 See Appellant's Opening Brief at 24, *Astaire* (No. 95-56632).

232 *Id.* at 24-25.

Astaire correctly responded that a state right of publicity claim is not equivalent to federal copyright since it contains elements that are different in kind from copyright.<sup>233</sup> For example, § 990 of the California Civil Code adds the element of proving that the individual whose persona has been misappropriated be someone whose identity has commercial value at the time of his or her death,<sup>234</sup> whereas a claim for copyright infringement is established merely by proving unauthorized copying, regardless of whether the subject of the copyrighted work has independent commercial value.<sup>235</sup>

Astaire further emphasized that, as *Midler* and *Waits* make clear, "the right of publicity coexists in perfect harmony with copyright protection, because each protects different intangible rights."<sup>236</sup> Whereas federal copyright law protects works of authorship that are fixed in a tangible medium of expression, the right of publicity, by contrast, protects various attributes of an individual's identity. Since it is the unauthorized use of the individual's identity, regardless of the medium in which the misappropriated attribute happens to appear, that constitutes a right of publicity violation, federal copyright law is not equivalent to, and therefore does not preempt the right of publicity which protects different rights entirely.

The *Astaire* case was decided on grounds apart from the federal preemption issue, so this case did not provide the appropriate circumstances and events for definitively determining whether federal copyright law preempts a state's right of publicity. Nonetheless, as evidenced by the incongruous body of decisions addressing this issue, it is imperative that either the Ninth Circuit or United States Supreme Court decide a case on the merits of this issue and hold that state right of publicity laws are distinct from, and immune from preemption by, the Federal Copyright Act of 1976. Such a finding, coupled with a detailed analysis in a published decision, would provide the consistency and guidance that courts require in deciding this issue. It also

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233 See *id.* at 29; see also *Waits v. Frito-Lay*, 978 F.2d 1093, 1100 (9th Cir. 1992) (quoting H.R. REP. NO. 94-1476, at 132 (1976), *reprinted in* 1976 U.S.C.C.A.N. 5659, 5748 (stating that a state law cause of action is not "equivalent" to the rights created by the Copyright Act, and is therefore not preempted, if it "contain[s] elements . . . that are different in kind from copyright infringement")).

234 CAL. CIV. CODE § 990(h) (West 1998) (stating that the individual whose persona has been misappropriated must be someone whose "name, voice, signature, photograph, or likeness has commercial value at the time of his or her death").

235 See Respondent's Opening Brief at 30, *Astaire* (No. 95-56632) (citing CAL. CIV. CODE § 990 and *Factors Etc., Inc. v. Pro Arts, Inc.*, 496 F. Supp. 1090, 1100 (S.D.N.Y. 1980) (finding no copyright preemption where plaintiff was required to prove commercial exploitation of name or likeness during celebrity's lifetime)).

236 Respondent's Opening Brief at 28, *Astaire* (No. 95-56632).

would provide a backdrop against which courts could conclude that the right of publicity is not preempted by federal copyright law.

## VI. CONCLUSION

Federal copyright law does not preempt the right of publicity because (1) a person's identity is neither a "work of authorship" nor "fixed in any tangible medium of expression," (2) identity is not a protectible expression, thus extending beyond the general scope of subject matter protected by copyright, and (3) the right of publicity is not equivalent to the exclusive rights of copyright since the right of publicity, in addition to being infringed by reproduction, distribution, or display, requires extra elements such as the defendant knowingly using the plaintiff's intangible identity for a commercial advantage and profiting by injuring the plaintiff's publicly recognizable persona.

Initially developed to protect the celebrity's proprietary interest in his or her name, image, and likeness, the right of publicity has expanded to cover persona and evocation-of-identity. Nonetheless, protecting an individual's persona and identity still differs from federal copyright law which grants a creator a temporary monopoly over the subject matter of his or her tangible creation in order to foster inventions and ingenuity. The right of publicity exceeds that by granting the creative individual an ownership interest in his or her intangible name, likeness, or identity. Thus, since the right of publicity exists to protect the intangible image and persona of an individual from unconsented exploitation whereas copyright law protects the different interest in the actual creation that has been reduced to a tangible form, the goals and protections are similar, but not equivalent.

Holding that individuals sacrifice publicity rights in their personas simply because their images become fixed in tangible media threatens the right of publicity of celebrities who, by the very nature of their work, are almost always captured on film, tape, or some other medium. An individual's likeness and persona are intangible property rights, distinct from those rights protected by the copyright of a tangible work. Furthermore, the right of publicity, even if reduced to a tangible form, is not equivalent to copyright since it requires proving the additional elements of the plaintiff's recognizable identity or use for the defendant's commercial advantage. Celebrities do not have the right to prevent anyone from copying films in which they appear but do not own under copyright law. What the copying party cannot do is exploit the commercial value of the celebrity's likeness to attract customers' attention and enhance the marketability of a prod-

uct that does not convey newsworthy, biographical, or fictional information about the celebrity.

The road to celebrity status is paved with humiliation, sacrifice, and self-doubt. Artists cradle hidden notions of the greatness they strive to achieve. Be they driven by fame or critical acclaim, trapped deep inside them is some unfathomable vision or impulse, screaming to be expressed. Getting even the opportunity to express their abilities requires enduring chilling auditions, humiliating cattle calls, money-consuming business minds, and an almost impenetrable road block of other obstacles.

If the fortunate artist becomes one of the few to realize his dreams, express her talents, or attain a marketable identity, the new-found celebrity deserves exclusive control of his or her publicity rights. Otherwise, individuals are relegated to watching without remedy as their identities and personas are used against their will for the undeserved advantage of another.

Furthermore, celebrity status does not die with the performer. To the contrary, a star's light often glows brighter after the performer passes away. Often we are left only with memories of the celebrity's persona and identity and the way the performer caused us to laugh, cry, or watch in awe. The star of our deceased performers deserves protection from the tarnishing touch of those who might attempt to exploit the persona for commercial gain. The best way to provide this protection is to allow a devisable right of publicity that is not preempted by federal copyright law.

Since celebrities spend time, money, and energy developing commercially lucrative identities, such personas are the fruit of their labors and deserve the protection, security, and other advantages, economic or otherwise, provided by the right of publicity. Considering the inconsistent treatment of the preemption issue by courts throughout the country, federal legislative action should be taken to provide consistent protection of publicity rights. Amending § 301 of the 1976 Copyright Act to expressly state that federal copyright law does not preempt the state right of publicity would ensure that a celebrity is neither left without remedy for the unconsented use of his persona nor stripped of his or her identity—the one thing no person should ever lose.

*Sean Elliott\**

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guidance, Stephanie Edwards for editing, Steve Yarovinsky and Andrew Ruf for late nights at the Atlantic research facility, Vince Chieffo and Keith Fleer for their time and suggestions, Sam Gores and Sandi Dudek for invaluable mentoring and exposure to vehement talent representation, all the agents at Paradigm for teaching by example, and mostly to my parents and brothers for believing that success is derived from risk, adversity, and the pursuit of passion.



